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Supreme Court of the United States

OCTOBER TERM, 1942

NO. 568

THE CONSOLIDATED EXPANDED METAL
COMPANIES, Petitioner,

v.

UNITED STATES GYPSUM COMPANY,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE
UNITED STATES CIRCUIT COURT OF APPEALS
FOR THE SIXTH CIRCUIT AND BRIEF IN SUPPORT
THEREOF.

WALTER J. BLENKO,
ARTHUR J. HUDSON,
Counsel for Petitioner.



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COMPANIES, Petitioner,

v.

UNITED STATES GYPSUM COMPANY,
Respondent.

PETITION FOR WRIT OF CERTIORARI.

*To the Honorable the Chief Justice and the Associate
Justices of the Supreme Court of the United States:*

Your petitioner, The Consolidated Expanded Metal Companies, respectfully prays for a writ of certiorari to the Circuit Court of Appeals for the Sixth Circuit to review the judgment of that court entered on October 6, 1942.

Summary Statement of the Matter Involved.

This is an infringement suit based on patent 1,950,372 which issued to petitioner on March 6, 1934 as the assignee of Leonard W. Cross¹. It is for an improved "expanded metal" free from burrs and sharp edges and a method and apparatus for manufacturing it.

¹ A copy of the patent appears at Rec. p. 11.

Expanded metal *per se* dates back to 1862². Since 1885 it has been universally made by a process invented by one Golding, and described in the opinion of this Court in *Expanded Metal Co. v. Bradford*, 214 U. S. 366. While it does not appear from that decision, the method of manufacture there described inherently produces sharp edges and ragged burrs upon the edges of the strands, which frequently caused injury³, or even death⁴, to persons handling the product. Bound at the back of this volume are cuts showing expanded metal and a characteristic burr.

The presence of these inherent defects early gave rise to "an insistent demand for expanded metal which was free from burrs and sharp edges"⁵, and "long before Cross many others had considered such smooth edged fabric as a desirable product, and had made various efforts to make it"⁶. But all of these efforts resulted in failure, and the problem remained unsolved for more than *forty years* until solved by Cross.

One of the concerns which tried, unsuccessfully, to satisfy this old and recognized want was respondent's predecessor, The North Western Expanded Metal Company⁷. North Western's try was induced by the rejection of a quantity of its expanded metal on the ground that it was *unsafe*, due to "Sharp edges or fins at the edges of openings" which were "very likely to cause lacerations, with an excellent chance of infection"⁸. The vendee reported the defect not merely to North Western,

² Rec. p. 2990.

³ Rec. pp. 2990-2991.

⁴ Rec. pp. 410-411.

⁵ Rec. p. 2882.

⁶ Rec. p. 2844.

⁷ Respondent succeeded to North Western's business April 1, 1930; Rec. p. 737. This was two years after Cross' date of invention.

⁸ Rec. p. 1956.

but also to the Underwriters' Laboratories, an organization which carries on a test and inspection service for insurers. This was in November, 1925. Through the succeeding months diligent efforts were made to improve the product, but in May, 1926, North Western's President, Mr. Foote, reported that it was "impossible" to eliminate "the rough or sharp edge" entirely, and that it was even impracticable to *minimize* the defect in any real degree, because "to do any better than we are doing" would require "dismantling the machines [in which the expanded metal is made] and grinding the knives so frequently that the cost would be prohibitive"⁹. The expedient of "grinding the knives" cannot eliminate the sharp edges. It does minimize their raggedness, but in so doing makes "an edge practically equivalent to *razor sharpness*"¹⁰.

The Cross invention is described in some detail in the brief accompanying this petition. It will suffice to say here that it utilizes the action of a high-speed rotary wire-bristled brush, applied to the expanded metal in a novel way. That the manner of application of the brush to the metal is important is shown by the fact that North Western's President, in his May 1926 letter⁹, said he had investigated the possibilities of using a wire brush, but "That did not work for various reasons, principally due to the *peculiarity of the material itself and the shape of the mesh*".

North Western also tried sand blasting without success.⁹

Petitioner has put the Cross invention into commercial use. The safe material went on the market in the Summer of 1931¹, and completely satisfied the forty-

⁹ Rec. p. 1973.

¹⁰ Rec. p. 184. Where italics appear in quotations, it will be understood that the emphasis is ours.

¹ Rec. p. 189.

year-old demand. It has had a marked commercial success and has displaced the unbrushed, unsafe material which was all the trade could theretofore supply. Late in 1931 or early in 1932—the date is not fixed precisely—respondent appropriated the invention and began competitive manufacture and sale at the insistence of its sales department². Prior to this respondent had been experimenting with the use of tumbling barrels to remove the burrs³, apparently without success.

The case was referred to a Special Master for trial. Although denying infringement in its answer⁴, respondent admitted infringement at the trial⁵ and consequently the sole issue was the validity of the patent. In the teeth of the facts, above recounted, as to the failures of its predecessor, North Western, to solve the problem, respondent based its defense in large measure on the defense that North Western had itself practiced the subject-matter of the patent prior to Cross. The Master rejected this and other prior use defenses, but nevertheless recommended the dismissal of the bill, on the following principal grounds:

The sole apparatus claim in suit (No. 18) was held invalid for lack of invention over Buckman patents 451,263 and 451,264, dated April 28, 1891⁶, and over two machines of the American Brass Company⁷. The Master conceded that none of these items of prior art had ever taught or been used for the treatment of expanded metal to remove burrs and sharp edges. The product claims (Nos. 15 and 16) were held invalid, claim 15 on

² Rec. p. 378.

³ Rec. p. 376.

⁴ Rec. p. 19.

⁵ Rec. p. 2893.

⁶ Rec. p. 2825. The Buckman patents were conceded by respondent's expert to be the most pertinent prior art; Rec. p. 541.

⁷ Rec. pp. 2841-2842.

the ground that it was drawn to subject-matter which was not inventive in character⁸ and claim 16 on the grounds that the patentee did not himself first reduce his conception of the product to practice nor show how it could be done, but that this was first done by The Manufacturers Brush Company in Cleveland, albeit on Cross' suggestion and at his behest⁹, and that there was lack of invention¹. The Master held that claim 16 was patentably distinct from claim 15. The method claims in suit (Nos. 10 to 14 inclusive) were held invalid on the ground that while "no prior art patents in evidence specifically disclose the method", they lacked invention over the prior art².

Both parties filed objections to the report. The District Judge overruled all of respondent's objections and sustained petitioner's principal objections, holding that the proper application of "authoritative patent decisions" to the facts required a holding that invention was present³.

So far as concerned the holding of the Special Master that The Manufacturers Brush Company, rather than Cross, had first reduced Cross' concept to practice, the District Judge held that the defense had not been made out; that, although the trial had been held in Cleveland, no witnesses had been called by respondent from the local plant to corroborate or to establish by necessary proof the alleged reduction to practice; that the incident "was a part of the Cross experiments and

⁸ Rec. p. 2888.

⁹ Rec. p. 2882.

¹ Rec. p. 2883.

² Rec. pp. 2892-2893.

³ Rec. pp. 2924-2927.

search for means and methods" and that whatever was done there inured to Cross' benefit⁴.

The District Judge sustained the Master's holding that product claim 15 was invalid⁵, and petitioner thereupon filed a disclaimer as to it⁶.

Respondent appealed to the Circuit Court of Appeals but did not challenge the holding of the District Court in rejecting the alleged North Western prior use or any other alleged use. The Court of Appeals reversed the District Judge as to all claims held valid by him, primarily on the ground that what Cross had done, although an "advance", lay "within the expected skill of the art"⁷. It disagreed with the Master's conclusion that claim 16 differed patentably from claim 15, now disclaimed, and held claim 16 invalid for that additional reason.

Reasons Relied Upon for the Allowance of the Writ.

Petitioner seeks no review of the evidentiary facts; cf. *Williams Mfg. Co. v. United Shoe Machinery Corp.*, 316 U. S. 364, 365. The discretionary power of the Court is invoked on the following grounds:

I. *Diversity of opinion in the courts below. No other opportunity to present the case.* The District Court, applying what it deemed to be the proper application of "authoritative patent decisions" to the facts "that there was objection in the industry to sharp edges and burrs; that there was a demand for sheets without sharp edges; and that, many others had considered smooth edged fabric a desirable product and had made various efforts to make it" and that "the Cross patent was the solution and the response to that objection and demand", found invention present and the patent conse-

⁴ Rec. p. 2926.

⁵ Rec. p. 2930.

⁶ Rec. p. 2936.

⁷ Rec. p. 2994.

quently valid, save for one product claim (No. 15), now disclaimed. The Court of Appeals, holding in substance that the decisions of this Court, applicable to such a state of facts, were nullified by the decisions in the *Schriber-Schroth* cases, 305 U. S. 47 and 311 U. S. 211, when considered in the light of its own prior holdings therein, concluded that these facts were not of moment, held that no invention was involved, and reversed the District Court. It is plain, from the respective opinions, that the diversity between the courts below is solely on the legal principles to be applied to agreed or undisputed facts.

The affidavit of Lewis McC. Steenrod filed herewith shows a concentration of the industry in the Sixth Circuit, together with other facts which render further litigation, resulting in conflict of decision among circuits, wholly improbable; cf. *Mackay Radio & Telegraph Co. v. Radio Corp. of America*, 306 U. S. 86, 89; *Schriber-Schroth Co. v. Cleveland Trust Co. et al.*, 305 U. S. 47, 50.

II. *Misunderstanding and misapplication, by the Court of Appeals, of decisions of this Court.* The decision of the Court of Appeals shows that the holdings of this Court in the *Schriber-Schroth* cases were deemed by it to be controlling on the issue of *invention*. The Court of Appeals misapprehended the *ratio decidendi* of those decisions. Neither of the decisions of this Court in the *Schriber-Schroth* litigation denied the existence of an invention. The decisions were on grounds wholly foreign to that question; namely, lack of original disclosure to support the claims (305 U. S. 47), and file wrapper estoppel (311 U. S. 211); yet Judge SIMONS' opinion in the case at bar holds, in essence, that because this Court reversed him in the *Schriber-Schroth* litigation this Court's decisions stating the affirmative rule of *invention* are nullified. The misunderstanding and misapplication of the *Schriber-Schroth* decisions by the Court of Ap-

peals is ground for certiorari; *Schriber-Schroth Co. v. Cleveland Trust Co. et al.*, 311 U. S. 211, 217; *Webster Electric Co. v. Splitdorf Electrical Co.*, 264 U. S. 463, 469.

III. *Failure to apply the applicable decisions of this Court.*

(a) The Court of Appeals conceded that there was no *anticipation* of the subject-matter of the patent, and that "adaptation" of the prior art disclosures would be required in order to effect Cross' "*advance*"¹, but held what he had done lay "within the expected skill of the art", despite the facts that "for many years there had been an insistent demand for such metal without the sharp edges"²; that "this record is replete with evidence introduced in behalf of both parties which is convincing that long before Cross many others had considered such smooth edged fabric as a desirable product, and had made various efforts to make it"³; that the problem had been worked at diligently by respondent's predecessor, whose President had finally characterized it as "impossible" of solution; that only after it had existed for more than *forty years* had it been solved by the patentee, Cross; and that the closest item of prior art had existed for *thirty-seven* of those forty years, without anyone seeing in it any solution of the problem.

Most of the rules of law for determining the question of invention are negative in their character, but this Court has long adhered to one affirmative rule; namely:

"Where the method or device satisfies an old and recognized want, invention is to be inferred, rather than the exercise of mechanical skill. For mere

¹ Rec. p. 2992, p. 2994.

² Rec. p. 2850.

³ Rec. p. 2844.

skill of the art would normally have been called into action by the generally known want"; *Paramount Publix Corp. v. American Tri-Ergon Corp.*, 294 U. S. 464, 474.

This rule, we submit, is controlling on the facts of the present case. But the Court of Appeals, on the ground that decisions prior to the *Schriber-Schroth* cases "are not very helpful"⁴; that the patent law is "presently in a state of flux"⁴; and because of the holdings of this Court in the *Schriber-Schroth* cases adverse to the patents there involved, despite "The evidence there of a long felt need and commercial acceptance of a solution * * * fully as dramatic as that here presented, if, indeed, not more so"⁵, refused to apply to the case at bar the rule of this Court laid down in the *Paramount* case and the long line of earlier decisions cited therein.

(b) The District Judge held that the adoption of the subject-matter by the respondent "speaks with undeniable force" on the issue of invention⁶. The Circuit Court of Appeals rejected that holding specifically. In so doing it went contrary to the holdings of this Court in *Krementz v. The S. Cottle Company*, 148 U. S. 556, 560⁷, in view of the facts (i) that the President of respondent's predecessor had asserted the problem was "impossible" of solution⁸, and (ii) that respondent's own efforts to solve it were all failures. And the case was not one of "open and adverse possession" of the patent, as the Court of Appeals seemed to assume⁹, be-

⁴ Rec. p. 2994.

⁵ Rec. p. 2998.

⁶ Rec. p. 2926.

⁷ Cited with approval in *Paramount Publix Corp. v. American Tri-Ergon Corp.*, 294 U. S. 464, 474.

⁸ Cf. *Krementz v. The S. Cottle Company*, 148 U. S. 556, 560.

⁹ Rec. p. 2990.

cause respondent appropriated the substance of the Cross development *before* the issuance of the patent in suit by securing information from the manufacturer who had supplied vital parts of petitioner's machine.

(c) In holding that the adaptations necessary to make the prior art disclosures effective to brush expanded metal must themselves involve invention in order to sustain the patent, the Court of Appeals went contrary to the rule laid down by this Court in *Hobbs v. Beach*, 180 U. S. 383, 392.¹⁰

(d) In holding the work done at Cross' behest by the Manufacturers Brush Company to be prior art against Cross, and in refusing to give him the benefit of it, the Court of Appeals went contrary to the rule laid down by this Court in *Agawam Company v. Jordan*, 7 Wall. 583, 602, and *Minerals Separation, Limited v. Hyde*, 242 U. S. 261, 270.

IV. Conflict with decisions of other Circuit Courts of Appeals.

(a) In relegating to limbo the rule of the *Paramount* case, above quoted, on the ground that the *Schriber-Schroth* cases are controlling on the question of *invention*, the Court of Appeals has rendered a decision in conflict with the decisions of other Circuit Courts of Appeals in cases subsequent to the *Schriber-Schroth* decisions, as follows:

Refractolite Corporation et al. v. Prismo Holding Corporation, 2nd Circuit (Feb. 24, 1941), 117 F. 2d 806, 807;

James P. Marsh Corp. v. United States Gauge Co., 7th Circuit (June 11, 1942) 129 F. 2d 161, 163-4.

¹⁰Cited with approval in *Paramount Public Corp. v. American Tri-Ergon Corp.*, 294 U. S. 464. 474.

(b) In rejecting the proposition that respondent's imitation was persuasive on the question of invention, the Court of Appeals has enounced a rule in conflict with the rule in the Second Circuit; *Kurtz v. Belle Hat Lining Co.*, 280 F. 277, 281.

(c) In holding that the adaptations necessary to make the prior art disclosures effective to brush expanded metal must themselves involve invention in order to sustain the patent, the Court of Appeals has enounced a rule of law in conflict with the rule in the Second Circuit; *White v. Converse*, 20 F. 2d 311, *Traitel v. Hungerford*, 18 F. 2d 66; and with the rule in the Seventh Circuit; *Rousso v. City Towel Supply Co.*, 242 F. 655.

(d) In denying the patentee the benefit of whatever experimenting was done by The Manufacturers Brush Company, the Court of Appeals has rendered a decision in conflict with the rule of law of the Circuit Court of Appeals for the District of Columbia; *Massey v. Ridge*, 270 F. 879; *Orcutt v. McDonald*, 27 App. D. C. 228.

V. *Public Importance.* The wide-spread discussion of the present day on the question of invention is doubtless known to the Court¹. The mere fact that members of the general public, and even scientists, have failed to discriminate between decisions on technical grounds, such as alteration of original disclosure and file-wrapper estoppel, on the one hand, and questions of invention on the other hand, is perhaps not to be deemed necessary of correction and enlightenment by this Court. But when, as in the case at bar, a Circuit Court of Appeals, which will ordinarily be the court of last resort of patentees in

¹ And see, for example, "Collier's" magazine, issue of Jan. 10, 1942, p. 54, editorial entitled "Fifteen to Nothing".

an important industrial section of the United States, deprives litigants of the benefit of the only affirmative rule of invention laid down by this Court, on the mistaken ground that it has been superseded by decisions which did not turn on the question of invention but rather on the technical grounds of alteration in original disclosure and file-wrapper estoppel, it is, we submit, of the utmost public importance that this Court exercise its discretionary powers and grant a review. Otherwise, patentees will be deprived of a just presumption and the incentives to invent and to invest in and commercialize inventions will be materially impaired, to the public detriment.

WHEREFORE, your petitioner respectfully prays that a writ of certiorari be issued out of and under the seal of this Court, directed to the Circuit Court of Appeals for the Sixth Circuit, commanding that court to certify and to send to this Court for its review and determination, on a day certain to be therein named, a full and complete transcript of the record and all proceedings in the case numbered and entitled in its docket, No. 8788, United States Gypsum Company, Appellant, v. The Consolidated Expanded Metal Companies, Appellee, and that the said judgment of the Circuit Court of Appeals for the Sixth Circuit may be reversed by this Honorable Court, and that your petitioners may have such other and further relief in the premises as to this Honorable Court may seem meet and just; and your petitioner will ever pray.

THE CONSOLIDATED EXPANDED METAL
COMPANIES

By WALTER J. BLENKO,
ARTHUR J. HUDSON,
Counsel for Petitioner.

Affidavit of Lewis McC. Steenrod.

State of Pennsylvania }
County of Allegheny } ss.:

LEWIS McC. STEENROD, being duly sworn, deposes and says, upon information and belief:

1. I am and have been since 1935 President of petitioner, The Consolidated Expanded Metal Companies. I am familiar with the expanded metal business in the United States and with the expanded metal products made by the various manufacturers of expanded metal.

2. Expanded metal made in the United States falls into two classes: (a) expanded metal which is used for reinforcement purposes such as reinforcement of concrete and plaster or is incorporated in metal castings such as brake shoes, and (b) expanded metal which is used for making machine guards, window guards, partitions, walkways, baskets and the like where the expanded metal is exposed to contact of the hands, body and clothing of people. The patent in suit is concerned with the removal of sharp edges and burrs which render expanded metal dangerous for the uses of class (b).

3. The business of making expanded metal is largely concentrated in the Sixth Circuit. Except petitioner, the only manufacturer of expanded metal in the United States outside of the Sixth Circuit is Penn Metal Company of Parkersburg, West Virginia. Almost the entire expanded metal production of Penn Metal Company has been used for brake shoe reinforcement in class (a) where the expanded metal is not exposed to human contact in use. Penn Metal Company does not own the expanded metal making machines which it uses; these are owned by American Brake Shoe & Foundry Company, a brake shoe manufacturer. Penn Metal Com-

pany does not now remove and never has removed the burrs and sharp edges from its expanded metal.

4. The construction of a machine embodying the principles disclosed in the patent in suit would involve the use of a large amount of critical materials and, under present regulations of United States Government departments, it would be impossible at this time for any manufacturer wishing to use the subject-matter of the patent in suit to construct a machine for practicing it.

5. Because of the foregoing, it is presently impossible, and in all probability it will continue to be impossible, to institute litigation in any other circuit to test the validity of the patent in suit.

LEWIS McC. STEENROD.

Sworn to and subscribed before me, a Notary Public in and for the said County and State, this 28th day of November, 1942.

[NOTARIAL SEAL]

JANE H. KEITH,
Notary Public.

My commission expires May 11th, 1944.



Supreme Court of the United States

OCTOBER TERM, 1942

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THE CONSOLIDATED EXPANDED METAL
COMPANIES, Petitioner,

v.

UNITED STATES GYPSUM COMPANY,
Respondent.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

I.

The Opinions of the Courts Below.

The opinion of the Court of Appeals is reported at 130 F. 2d 888, and appears at p. 2989 of the printed record. The opinion of the District Court is reported at 44 USPQ 673 and appears at p. 2924 of the record. The report of the Special Master appears at p. 2809.

II.

Jurisdiction.

(1) Jurisdiction is invoked under Section 240(a) of the Judicial Code; 28 U. S. C. Section 347. This is a suit in equity arising under the patent laws of the United States. Judgment was entered by the Circuit Court of Appeals on October 6, 1942. The judgment is final in that it requires that the complaint be dismissed.

(2) Decisions believed to sustain the jurisdiction are as follows:

Schriber-Schroth Co. v. Cleveland Trust Co. et al., 311 U. S. 211, 217;

Mackay Radio & Telegraph Co. v. Radio Corp. of America, 306 U. S. 86, 89;

Schriber-Schroth Co. v. Cleveland Trust Co. et al., 305 U. S. 47, 50;

Paramount Public Corp. v. American Tri-Ergon Corp., 294 U. S. 464;

Altoona Public Theatres, Inc. v. American Tri-Ergon Corp., 294 U. S. 477;

DeForest Radio Co. v. General Electric Co., 283 U. S. 664, 669;

Webster Electric Co. v. Splitdorf Electrical Co., 264 U. S. 463, 469.

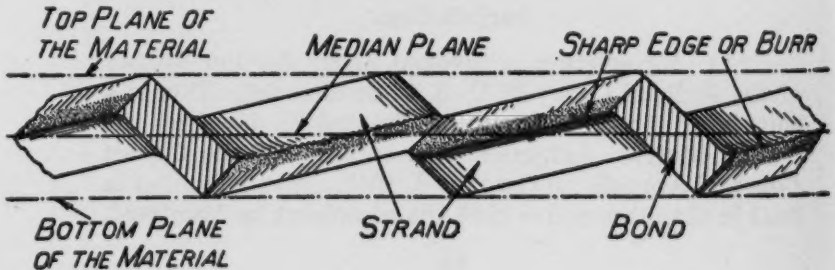
III.

Statement of the Case.

In addition to the facts stated in the foregoing petition, the following is submitted:

THE CROSS INVENTION.

The burrs and sharp edges are inside of the diamonds which make up the mesh-work. This is shown by the cuts bound at the back of this volume. In addition, we here insert an illustrative sketch.



As shown in the illustration, the bonds and strands are both tilted with respect to the bounding planes of the sheet, considered as a whole. Due to this peculiarity of expanded metal, the burrs and sharp edges do not lie on the surface planes, but wholly between these bounding planes. The hand may be laid flat on the surface of the sheet and rubbed over it with impunity, but *within* the diamonds there are razor-sharp edges. These edges extend up into the "crotches" of the diamonds and lap over one another, as will be seen from the first half-tone illustration bound at the back of this volume. Consequently, the problem is wholly different from that of merely cleaning the bounding surface plane of an imperforate metal body, such as a solid sheet. The attempts of respondent's predecessor to remove these edges by using wire brushes failed, "principally due to the peculiarity of the material itself and the shape of the mesh"¹.

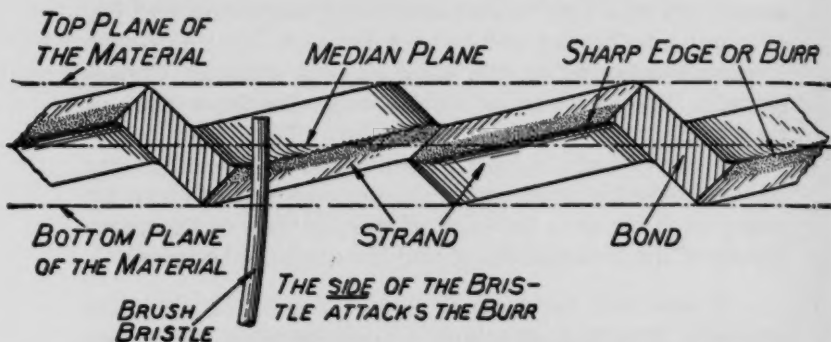
It was not for lack of a suitable brush that the problem remained unsolved. Such brushes were just about as old as the problem, being shown in Wooster patent 82,780 of October 6, 1868². And as early as 1891 brushes of this sort had been organized into a machine for cleaning the surfaces of imperforate sheet metal plates³. Cross used these brushes (a) on a *material*—expanded metal—never before so treated; (b) *in a new way*, so that the brush bristles *functioned* differently from the way they had theretofore functioned and thereby (c) produced a *new result*; namely, a safe expanded metal which satisfied the forty-year-old want.

¹ Rec. p. 1973.

² Rec. p. 2393.

³ Buckman patents 451,263, Rec. p. 2401, and 451,264, Rec. p. 2409. Respondent's expert conceded, Rec. p. 541, that no closer approach to the Cross invention could be found in the prior art than the disclosures of the Buckman patents, and the Court of Appeals was apparently of the same view; Rec. p. 2992.

Cross' new mode of using the wire brushes consists in utilizing their "side" action instead of the "tip" action of the prior art. The side action of the brushes is well illustrated in Figure 3 of the patent and is described in detail in the specification, page 3, line 70 et seq. We here insert an illustration which corresponds to Figure 3 of the patent but which shows only a single brush bristle.



The bristle shown in the foregoing illustration must be imagined to be moving away from the eye of the reader. It will be noted that the bristle projects into the open diamond, its tip extending beyond the median plane of the sheet of mesh to be treated. As the bristle moves forward its side engages the jagged or razor-sharp edge of the strand and slides across that edge. By reason of the high speed at which the bristle is moving, there is a process of attrition resulting in the removal of metal from that edge, and innumerable repetitions of this action effect a rounding which makes the strand edge safe.

The work is done by the *sides* of the bristles—the *tips* do not function at all; whereas in the surface cleaning of imperforate sheets by bristled brushes, the *tips* alone function and the *sides* play no part. This side action requires that the brushes and the expanded metal

fabric be relatively so located that the brush bristles extend to or beyond the median plane of the fabric. And the brushing must be lengthwise of the diamonds. The patent describes and claims both these matters.

THE INVENTION SATISFIED AN OLD AND RECOGNIZED WANT.

The invention gave the public, for the first time in the expanded metal art, a *safe* product, which fully satisfied the want that had been recognized but had gone unsatisfied for more than *forty years*, despite all efforts of the skilled workers in the art to solve the problem. Injuries due to cutting the hands have been entirely eliminated¹ and new uses for the material have been opened up². The material has completely displaced the old unsafe product of comparable size in the market³ and an impressive record of commercial success has been built up⁴.

RESPONDENT'S FAILURE TO SOLVE THE PROBLEM.

It has been shown in the petition that respondent's predecessor failed to solve the problem, and characterized it as "impossible" of solution. Respondent's own record, prior to its appropriation of the Cross invention, is also one of futility. Respondent's superintendent, Gibson, after conceding that the sharp edges were "Very much of a hazard"⁵, told of a workman in the plant who had a finger sliced off by the sharp edges of the expanded metal forming a partition. This was in 1928, when Cross completed his invention, but respondent knew nothing

¹ Rec. pp. 217-8, 252, 419, 423, 444.

² Rec. pp. 251, 291, 433, 445.

³ Rec. p. 189.

⁴ Rec. pp. 188-189, 2065.

⁵ Rec. p. 727.

better than to cover the metal with boards, Gibson admitting:

"Q. That was your solution of the problem in 1928?

A. That is correct."⁶

RESPONDENT'S COPYING WAS INDUCED BY PETITIONER'S SUCCESS.

After petitioner's material came on the market in the middle of 1931, the trade insisted upon having its metal "thoroughly brushed * * * free from burrs" and "the absolute equal" of petitioner's product¹. In the latter part of 1931, at the insistence of its sales manager, respondent had begun to try to debur its expanded metal, first by a tumbling process which was abandoned². Late in 1931 or early in 1932 respondent procured a number of sheets of petitioner's brushed expanded metal.³ It then located the source from which petitioner was securing its brushes⁴ and sought "information relative to the removal of a very sharp burr from our expanded metal by means of a wire brushing machine * * * as soon as possible"⁵. It will be borne in mind that this was prior to the issuance of the patent in suit. So aided, respondent built its admittedly infringing machine.

THE PRIOR ART.

Respondent concedes that the Buckman patents are the most pertinent prior art references¹. The Court of Appeals concedes that "a precise anticipation of the

⁶ Rec. p. 727.

¹ Rec. pp. 2002-2004.

² Rec. p. 376.

³ Rec. pp. 262-3.

⁴ Rec. pp. 383-384.

⁵ Rec. pp. 2005-2006.

¹ Rec. p. 2992.

Cross apparatus does not appear" and further that "some adaptation would have been required" to make the Buckman machine function like the Cross machine, but held that "the advance made by Cross must be construed as within the skill of the art rather than invention, * * *"². The Buckman patents came into the art in 1891 but, despite the "insistent demand", it was not until 37 years later—in 1928—that the problem was solved. And no one saw in the Buckman patents any relation to the problem until their resurrection for the defense of this suit.

The Buckman machines teach no more than the application of scouring powder to the surfaces of solid (imperforate) plate metal for the removal of "loose scales or other impurities clinging thereto", "just like a housewife polishing her silver plate with a brush and a little cleaning powder"³. There is no thought of removal of burrs and sharp edges within the diamonds of expanded metal, and the mode of action for this latter operation, namely, side action of the bristles, is nowhere suggested.

As further showing that "the advance made by Cross must be construed as within the skill of the art, rather than invention", the Court of Appeals referred to two machines of the American Brass Company⁴. These machines were also used for the surface cleaning of imperforate slabs. Although available to the art for sixteen years or more prior to the Cross development, no one had ever seen in them any way of removing burrs and sharp edges from expanded metal. They were used for that purpose by dint of adjustments and a mode of operation employed only once in their history. And that

² Rec. p. 2994.

³ Rec. p. 542.

⁴ Rec. p. 2994.

occasion was *twenty-five years after the machines had first been put into use and solely for the purposes of this case*. The designer of the machine, asked why a procedure so different from the normal operation of the machine had been employed on the test, replied "I do not know; I was directed to do so"⁵. The District Judge properly said "Knowledge of the Cross machine and his method were implicit in what was done there"⁶.

THE EXPERIMENTS OF THE MANUFACTURERS BRUSH COMPANY.

Cross, the patentee, whose experience in the expanded metal art began in England prior to 1913¹, became superintendent of petitioner's plant in 1925. Petitioner had "had lots of complaints"² about the sharp edges and burrs on expanded metal, and Cross attacked the problem of removing them. He first tried pickling, but without success. He experimented with the knives on the machines for making the expanded metal. Then he suggested that the sharp edges could be removed by brushing³. The Manufacturers Brush Company was a maker of metal brushes and Cross instructed petitioner's purchasing agent to send specimens to it for brushing. A covering letter dated February 19, 1926 was sent saying "What we are interested in knowing is whether the sharp edges can be removed with the wire brush * * *"⁴. The Brush Company reported a few weeks later that the "sharp edges can be removed" and that the samples were being returned "thoroughly

⁵ Rec. p. 937.

⁶ Rec. p. 2926.

¹ Rec. p. 1717.

² Rec. p. 1718.

³ Rec. p. 1719.

⁴ Rec. p. 2121.

cleaned"⁵. There was no disclosure at any time by the Brush Company to Cross as to any of the details of the brushing and respondent adduced no proof whatever as to the manner in which the samples were treated by The Manufacturers Brush Company, although, as pointed out by the District Judge⁶, the trial was held in Cleveland where The Manufacturers Brush Company was located.

The only testimony as to the success of the attempts of The Manufacturers Brush Company to remove the sharp edges is that of Cross himself, who said that the samples were not satisfactory⁷. Further questioning by the Master elicited the statement⁸ that the sharp edges and burrs were not removed from the strands "all over the sheet, or in the corners of the sheet, in the V's".

It was not until after further extensive work and experimentation, extending into the year 1928, that Cross worked out the factors of (a) setting the brushes in such relation to the work as to obtain a side action of the bristles and (b) brushing lengthwise of the diamonds⁹.

⁵ Rec. p. 2123.

⁶ Rec. p. 2926.

⁷ Rec. p. 1720.

⁸ Rec. p. 1790.

⁹ Rec. pp. 1731-1732.

IV.**Specification of Errors.**

If the writ is granted, the following errors will be urged:

1. The Court of Appeals erred in finding and holding that the Cross patent is invalid and in directing that the complaint be dismissed.

2. The Court of Appeals erred in finding and holding the patent void for lack of invention over the prior art.

3. The Court of Appeals erred in failing to hold that invention, rather than the exercise of mechanical skill, on the part of Cross, was to be inferred from the fact that the Cross method and device satisfied an old and recognized want.

4. The Court of Appeals erred in finding and holding that claim 16 of the Cross patent does not differentiate patentably from claim 15.

5. The Court of Appeals erred in finding and holding that claim 16 of the patent in suit is not patentable because of the acts of The Manufacturers Brush Company.

6. The Court of Appeals erred in failing to hold that the acts of The Manufacturers Brush Company, done at Cross' behest, inured to his benefit.

7. The Court of Appeals erred in reversing the judgment of the District Court and directing the dismissal of the Bill.

V.

Summary of Argument.

A. The Court of Appeals misunderstood and misapplied the decisions of this Court in the *Schriber-Schroth* cases. The Court of Appeals erroneously concluded that the decisions of this Court in the *Schriber-Schroth* cases nullified prior controlling decisions of this Court stating an affirmative rule of invention. In point of fact, the *Schriber-Schroth* decisions had no such effect but were based on the purely technical questions of (a) alteration and enlargement of original disclosure and (b) file-wrapper estoppel.

B. The decision of the Court of Appeals is contrary to the controlling decisions of this Court.

C. The decision of the Court of Appeals is in conflict with the decisions in other Circuits on the same points of law.

D. The questions involved are of such public importance as to call for the issuance of the writ.

VI.

ARGUMENT.

Point A. The Court of Appeals misunderstood and misapplied the decisions of this Court in the *Schriber-Schroth* cases.

Petitioner urged upon the Court of Appeals the applicability to the facts at bar of the doctrine of *Paramount Publix Corp. v. American Tri-Ergon Corp.*, 294 U. S. 464, 474. Although not adverting to the *Paramount* case by name, the Court of Appeals considered the argument¹ and rejected it, primarily because of the decisions of this Court in the *Schriber-Schroth* cases², saying that "older cases are not very helpful", that "the patent law is presently in a state of flux", and that the decisions in the *Schriber-Schroth* cases have made it "forcibly clear" that "commercial success or the apparent solution of a long perceived problem will not of itself vitalize an otherwise invalid patent".

The first *Schriber-Schroth* decision by this Court (305 U. S. 47) turned purely on a question of alteration and enlargement of original disclosure. Nowhere did this Court say that an invention had not been made but merely that the thing which the Court of Appeals had stated to be the invention was not disclosed in the Gulick and Maynard applications. Indeed, in the second *Schriber-Schroth* decision, 311 U. S. 211, 214, this Court said that "for that reason *alone* we held that * * * both patents failed to satisfy the requirements of the statute * * *".

¹ Rec. p. 2997.

² Rec. p. 2994, p. 2998.

An indication of the complete misinterpretation of this Court's opinions in the *Schriber-Schroth* cases is found in the comment of the Court of Appeals that the evidence in the *Schriber-Schroth* cases "of a long felt need and commercial acceptance of a solution was fully as dramatic as that here presented, if, indeed, not more so"³. Long felt need and commercial acceptance of a solution are factors which obviously could have no influence on the questions which were decisive of the *Schriber-Schroth* cases.

We assume this Court deemed that its first *Schriber-Schroth* decision was misinterpreted by the Court of Appeals, for this Court's second decision states that certiorari was granted for the second time on a petition which raised the question "whether the Court of Appeals had misinterpreted or unduly limited this Court's earlier decision in this case * * *". It seems plain from the decision in the case at bar that the Court of Appeals has continued to misinterpret the first *Schriber-Schroth* decision and has misinterpreted the second one as well. On the authority of the second *Schriber-Schroth* case and *Webster Electric Co. v. Splitdorf Electrical Co.*, 264 U. S. 463, 469, it is submitted that the writ of certiorari should issue to correct the error.

Point B. The decision of the Court of Appeals is contrary to the controlling decisions of this Court.

(a) This Court said in *Paramount Publix Corp. v. American Tri-Ergon Corp.*, 294 U. S. 464, 474:

"Where the method or device satisfies an old and recognized want, invention is to be inferred, rather than the exercise of mechanical skill. For mere skill of the art would normally have been called into action by the generally known want."

³ Rec. p. 2998.

In support of this proposition, the *Paramount* case cites a long line of earlier decisions of this Court, including, interestingly enough, *Expanded Metal Co. v. Bradford*, 214 U. S. 366, 381, which holds:

"It may be safely said that if those skilled in the mechanical arts are working in a given field and have failed after repeated efforts to discover a certain new and useful improvement, that he who first makes the discovery has done more than make the obvious improvement which would suggest itself to a mechanic skilled in the art, and is entitled to protection as an inventor".

The Golding invention, there upheld, was made "about ten years" after the patentee, with one Durkee, had introduced the earlier method of manufacture. The earlier method functioned well enough for expanded metal to become "extensively used and recognized as a new commercial article"⁴. In the case at bar the problem remained unsolved for *over forty years*, and prior to Cross' invention its solution was characterized as "impossible".

The decision of the Court of Appeals is not based upon the opinion of any witness that what Cross did was "within the expected skill of the art". That is the mere inference which the court drew. In view of the doctrine of the *Paramount* case, and the earlier decisions of this Court therein quoted, we submit that the inference may not be legitimately drawn. In essence, the decision of the Court of Appeals says that the men in the art *should* have seen the solution to their problem and the fact that they did not see it is of no moment. Such an inference may legitimately be drawn where the solution to a problem follows quickly on its presenta-

⁴ 214 U. S. 366, pp. 367-368.

tion, but not, under the decisions of this Court, in circumstances like those at bar.

(b) This Court said in *Krementz v. The S. Cottle Company*, 148 U. S. 556, 560:

"The view of the court below, that Krementz's step in the art was one obvious to any skilled mechanic, is negated by the conduct of Cottle, the president of the defendant company. He was himself a patentee under letters granted April 16, 1878, for an improvement in the construction of collar and sleeve buttons, and put in evidence in this case. In his specification he speaks of the disadvantages of what he calls 'the common practice to make the head, back and post of collar and sleeve buttons separate, and to unite them by solder'. His improvement was to form a button of two pieces, the post and base forming one piece, and then soldering to the post the head of the button as the other piece. *Yet, skilled as he was, and with his attention specially turned to the subject, he failed to see, what Krementz afterwards saw, that a button might be made of one continuous sheet of metal, wholly dispensing with solder, of an improved shape, of increased strength, and requiring less material.*"

The District Judge applied the logic of this decision to the facts at bar as "added support"⁵ for his conclusion that the patent exhibited invention, saying that respondent's adoption of the invention "speaks with undeniable force". The Court of Appeals, at the outset of its opinion⁶, took vigorous exception to this statement, characterized it as "illogical", and indicated that its own contrary view was "elementary". There is no factual difference which renders the *Krementz* case in-

⁵ Rec. p. 2926.

⁶ Rec. pp. 2989-2990.

applicable to the facts of the case at bar. To the contrary, the reasoning is even more applicable here because respondent not only failed to solve the problem⁷, but the President of its predecessor characterized its solution as *impossible*.

(c) This Court said in *Hobbs v. Beach*, 180 U. S. 383, 392:

"With all the anticipating devices before us, it is apparent that the mere change in the shape of the dies was a minor part of the work involved in so changing the Dennis and York machine as to make it perform a wholly different function, the invention consisting rather in the idea that such change could be made, than in making the necessary mechanical alterations. As stated by Judge Coxe in his opinion in *Beach v. American Box-Machine Co.*, 63 Fed. Rep. 597, 'the question is whether a mechanic before any one had thought of pasting stay strips to the corners of boxes by machinery, would construct the Beach machine after seeing the labeling machine. Would the latter suggest the idea and the embodiment of the idea? Would the thought enter the mind of the skilled mechanic with the Dennis and York device before him on his work bench; and if it did, would it not be a creative thought whose presence would convert the mechanic into an inventor?'"

In the case at bar, the Court of Appeals conceded that "some adaptation would have been required" in the prior art machines to make them effective to remove burrs and sharp edges from expanded metal, but held that there could be no invention unless those adaptations themselves involved invention⁸, whereas this Court

⁷ Ante pp. 19-20.

⁸ Rec. pp. 2992-2993.

expressly held in *Hobbs v. Beach* (p. 391) that Beach's changes in the Dennis and York machine did not, in themselves, require invention. The *function* of the Dennis and York machine was to cut off the gummed paper slip carrying a postal address and automatically affix it to a newspaper, envelope or the like, while the function of the Beach machine was to cut off a gummed paper slip and automatically affix it to a cardboard box for the purpose of holding the corners together. In the case at bar the function of the Buckman machine—concededly the closest reference—is to apply scouring powder to the surface of solid sheets of plate metal for the purpose of removing “loose scales or other impurities clinging thereto”, “just like a housewife polishing her silver plate with a brush and a little cleaning powder”⁹. There is no disclosure of the removal of shear fins, burrs or slivers⁹. It is plain, therefore, that the difference in function between the Cross patent and the Buckman patent is considerably greater than the difference in function between the Beach machine and the Dennis and York machine.

(d) This Court said in *Agawam Company v. Jordan*, 7 Wall. 583, 602:

“No one is entitled to a patent for that which he did not invent unless he can show a legal title to the same from the inventor or by operation of law; but where a person has discovered an improved principle in a machine, manufacture, or composition of matter, and employs other persons to assist him in carrying out that principle, and they, in the course of experiments arising from that employment, make valuable discoveries ancillary to the plan and preconceived design of the employer, such suggested improvements are in general to be re-

⁹ Rec. p. 542.

garded as the property of the party who discovered the original improved principle, and may be embodied in his patent as a part of his invention."

The principle was reiterated in *Minerals Separation, Limited v. Hyde*, 242 U. S. 261, 270.

In the present case Cross initiated whatever was done by The Manufacturers Brush Company by sending specimens to it with a directive to ascertain "whether the sharp edges can be removed with the wire brush". It is evident that if Cross had not done this, The Manufacturers Brush Company would not have run the test. The report of the Brush Company to Cross was in the affirmative, albeit the only evidence as to the success of the Brush Company is that it had failed to remove all of the burrs and sharp edges or to remove them from the V's of the diamonds¹⁰. It is plain, therefore, that the Brush Company did not do more than Cross directed it to do but failed to do all that he wanted done. Cross had to carry on further extensive work before he achieved success.

We quote further from the *Agawam* case as follows:

"Suggestions from another, made during the progress of such experiments, in order that they may be sufficient to defeat a patent subsequently issued, must have embraced the plan of the improvement, and must have furnished such information to the person to whom the communication was made that it would have enabled an ordinary mechanic, without the exercise of any ingenuity and special skill on his part, to construct and put the improvement in successful operation."

It is plain that the reports of The Manufacturers Brush Company do not fall within the purview of the language

¹⁰ Ante p. 23.

just quoted, as is shown by the fact that long-continued work on the part of Cross was required before he achieved success.

We submit that in each of the particulars above discussed the Court of Appeals has so departed from and shown such disregard of controlling decisions of this Court that the writ of certiorari should issue to correct the error.

Point C. The decision of the Court of Appeals is in conflict with the decisions in other circuits on the same points of law.

In the foregoing petition, under the statement of reasons relied upon for the allowance of the writ, decisions of other Circuit Courts of Appeals have been cited to show conflict of the opinion of the Court of Appeals in the case at bar with the decisions of those other Courts of Appeals. Since in each instance the conflict is in respect of a point wherein the Court of Appeals in the case at bar is likewise in conflict with controlling decisions of this Court, as set forth immediately above, it is not deemed necessary to enlarge upon the proposition here. It is submitted that the writ of certiorari should issue to resolve the conflicts.

Point D. The questions involved are of such public importance as to call for the issuance of the writ of certiorari.

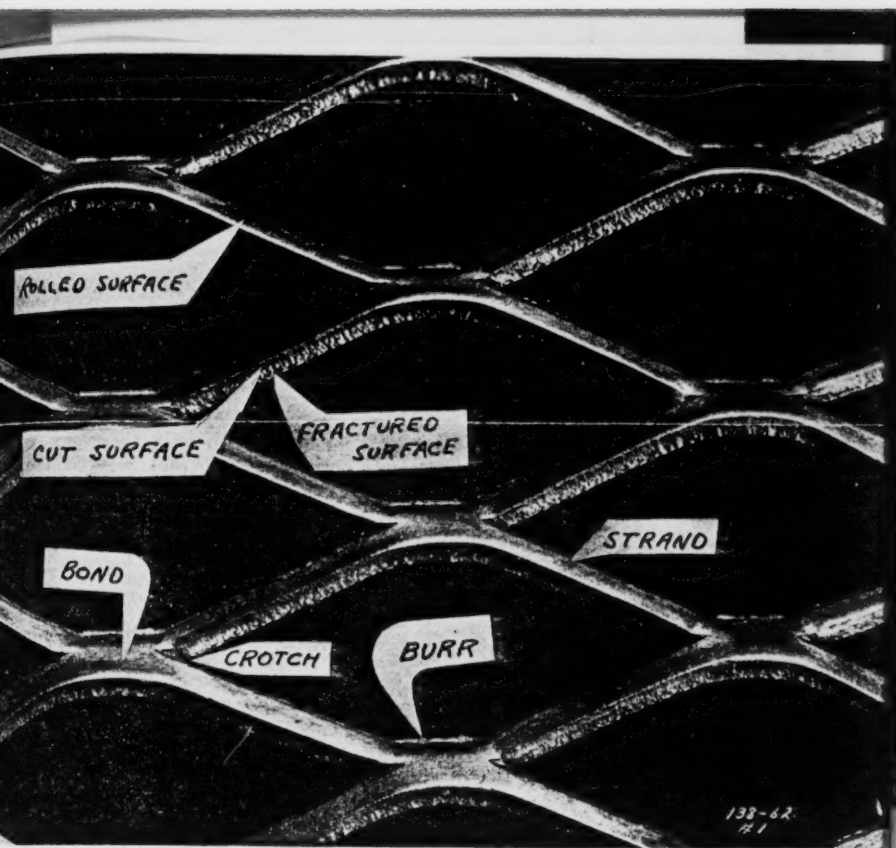
The public importance of the primary question here involved has been fully developed in the petition and requires no further discussion here.

Conclusion.

For the foregoing reasons, it is respectfully submitted that the petition should be allowed and the judgment of the Circuit Court of Appeals for the Sixth Circuit reviewed and reversed.

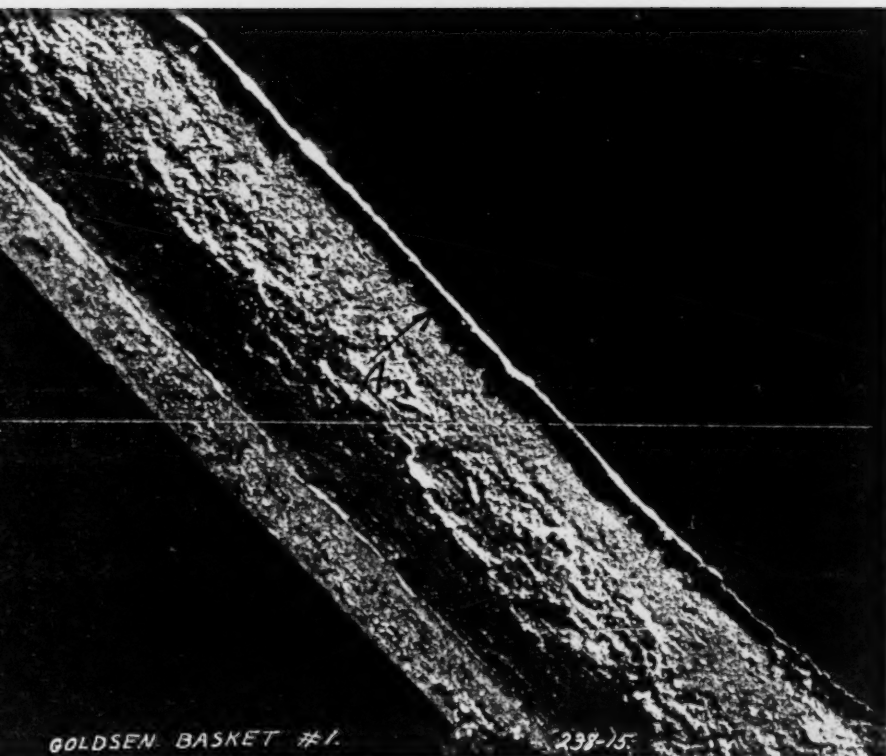
Respectfully submitted,

WALTER J. BLENKO,
ARTHUR J. HUDSON,
Counsel for Petitioner.



REPRODUCTION OF EXHIBIT 132 (Rec. p. 2097)
ILLUSTRATING EXPANDED METAL.





GOLDSER BASKET #1.

238-15

REPRODUCTION OF EXHIBIT 142 (Rec. p. 2099)
ILLUSTRATING A CHARACTERISTIC BURR "A".



(30) 11

CHARLES ELMORE CHAPLEY
CLERK

IN THE
SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1942

No. 568.

**THE CONSOLIDATED EXPANDED METAL
COMPANIES,**

Petitioner,

vs.

UNITED STATES GYPSUM COMPANY,

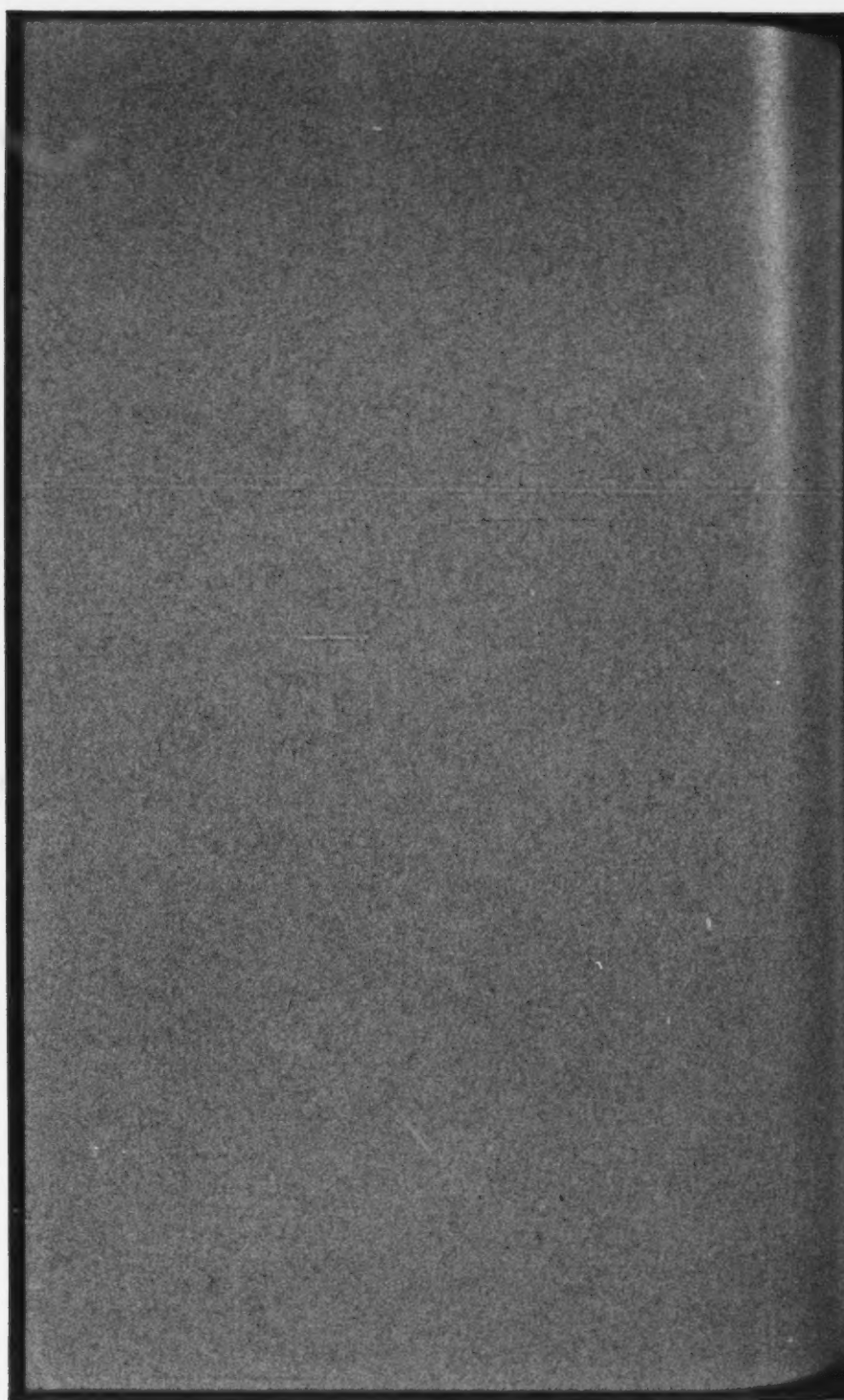
Respondent.

**BRIEF FOR RESPONDENT IN OPPOSITION TO
PETITION FOR WRIT OF CERTIORARI.**

ARTHUR A. OLSON,

ALBERT H. PENDLETON,

Counsel for Respondent.



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Respondent.

**BRIEF FOR RESPONDENT IN OPPOSITION TO
PETITION FOR WRIT OF CERTIORARI.**

Foreword.

The petition in this case seeks review of a decision of the Circuit Court of Appeals for the Sixth Circuit, by Simons, J., holding all of the patent claims in suit invalid for want of invention over prior art, knowledge and uses.

No conflict with decisions in other cases exists and no important question of law is involved. The only issue is that of invention, which has been determined upon proper and careful consideration of the evidence. It is significant that petitioner did not apply for a rehearing in the Court of Appeals.

Counter Statement of Facts.

Since the essential facts of the case are considerably obscured and distorted in the petition, a more accurate and informative statement is believed to be in order.

It is true that expanded metal is a very old and well-known material of commerce. It is made in different ways (not universally by the "Golding" process as asserted in the petition, p. 2), but some type of shearing operation is always involved, which inherently produces burrs and sharp edges along the slits or cut portions (Cross patent, Rec. p. 11, lines 7-20). These burrs and sharp edges are no different, however, from those produced by the shearing of any metal sheet or the like (Rec. pp. 77, 921-2). The product takes its form from the distention of the openings cut therein, either as a part of the same operation or as a result of a subsequent operation, this form constituting an open meshwork having several times the area of the original plain metal sheet. Naturally the burrs and sharp edges remain in the expanded product along the lines where the original metal sheet was slitted or otherwise cut.

The Cross patent in suit purports to cover the removal of such burrs and sharp edges by the application of wire brushes to the open meshwork sheets. The petition states (p. 3) that the brushes are applied "in a novel way," but it does not explain anything novel about the operation. Actually, the brushes are applied in the only conceivable way of applying them, that is, by bringing them to bear against the meshwork sheets with sufficient pressure to accomplish the desired result.

Relative movement is naturally effected between the brushes and the sheets so that the whole sheets are brushed, and in a single operation or in successive operations both sides of each sheet are brushed. Oppositely rotating brushes are used for maximum effectiveness in brushing all of the edges of the meshwork openings, although this feature is not specified in any of the claims in suit. Some but not all of the claims call for relative movement between the brushes and the meshwork substantially parallel

to the long dimension of the meshwork openings, so petitioner's brief (p. 19) contradicts the patent in saying the brushing *must* be done in that direction.

Petitioner admits (Br. p. 17) that brushes suitable for this work date back at least to 1868. Its expert also admitted that the Cross patent lies in the old scratch brushing art (Rec. p. 107). The primary features of organization of the Cross patent machine are fully disclosed in the prior art, as for example in the Buckman patents of 1891 (Def. Exs. 558, 559, Rec. pp. 2397, 2403, offered p. 459). Each of these patents shows two oppositely rotating brushes located on each side of the path of travel of sheets through the machine, exactly as is shown in the patent in suit. Petitioner states (Br. pp. 21, 31) that the Buckman patents "teach no more than the application of scouring powder to the surfaces of solid (imperforate) plate metal" and *makes no reference at all to the brushes*. The fact is that the brushes are the primary elements of the Buckman machines and the scouring powder is used merely to supplement or enhance the action thereof.

All that is involved in the patent in suit, therefore, is the use of brushing machines of the prior art to operate upon expanded metal, which differs only in *form* from the materials specifically referred to in the prior art. The suitability of wire brushes for treating material having irregular surfaces is a matter of common knowledge, as illustrated, for example, by the Broderick patent of 1907, which refers specifically to the advantage of using oppositely rotating brushes as follows:

"* * * By this arrangement all parts of all surfaces, whether flat, depressed or raised, are reached by the bristles or wires and thoroughly scoured or bur-nished." (Rec. p. 2446, lines 4-7, Def. Ex. 563, offered p. 459.)

There is ample evidence that the brushing machines of the prior patent art would satisfactorily perform the function of the Cross machine (Rec. pp. 469, 474-6, 479-90, 1114-6, etc.). Beyond this, however, the operability of two actual prior use brushing machines was demonstrated by *inter partes* tests preliminary to the trial of this case. The specimens of expanded metal brushed in the course of these tests stand unquestioned as "commercially practical products" (Rec. pp. 697-9, 2839, 2994).

Contrary to petitioner's contentions, the machines were adjusted and operated for these tests in a perfectly normal manner, by the workmen who regularly ran them (Rec. pp. 849-52, 931, 950). Petitioner concedes (Br. p. 21) that these machines have been in public use by The American Brass Co. since many years prior to the application for the patent in suit. The evidence clearly shows that while the said machines were never used commercially for the brushing of material in the specific form of expanded metal, they were regularly used to brush sheared metal sheets having burrs and sharp edges thereon, which were satisfactorily removed by the brushes (Rec. pp. 828-9, 845-6, 921-2, 938-9, 945).

Another point upon which clarification of the statement of facts is needed is that of development of the alleged invention by The Manufacturers Brush Co. rather than by the patentee, Cross. Petitioner claims for the patentee the benefits of the Brush Co. development (Pet. & Br. pp. 5-6, 11, 22-4, 31-3), but all it did to instigate such development was to write a letter, through its purchasing agent, telling the Brush Co. simply—

"What we are interested in knowing is whether the sharp edges can be removed with the wire brush, and if so, we would appreciate your returning the samples with the sharp edges removed, and also quoting us on

the equipment necessary to do this work." (Pl. Ex. 254(2), Rec. pp. 2121-2, offered p. 1749.)

No instructions or suggestions were given by Cross or petitioner to the Brush Co. as to what kind of brushes should be used, how the brushing should be done, or anything else.

In response to the above-quoted general inquiry the Brush Co. replied in a short time—

"It is with pleasure we advise you that these sharp edges can be removed with one of our 15" diameter, #415 Samson Wheel Brushes and we are returning the samples, thoroughly cleaned, under separate cover this mail." (Pl. Ex. 254(4), Rec. p. 2123, offered p. 1749.)

These samples were not produced at the trial, although called for by respondent (Rec. p. 1850), but the evidence as well as the inference is clear that they were at least reasonably well smoothed (Rec. pp. 1719-20, 1790-91). No subsequent improvement could have been anything more than in slight degree.

Another letter from the Brush Co. to petitioner (Pl. Ex. 254(5), Rec. pp. 2124-5, offered p. 1749), following very shortly after the above, gave detailed recommendations as to a commercial brushing machine design, including type and size of brush, speed and power requirements, etc., none of which was substantially departed from in petitioner's ultimate commercial machine (Def. Ex. 556, Rec. p. 2391, offered p. 457).

Petitioner's "insistent demand" argument is made in the face of the fact that *it was over five years later before its brushed expanded metal was put on the market*, and at best only two years of that time is accounted for by Cross's alleged further improvements (Rec. pp. 189, 1731-2). The

brushed material, when it finally did come out, was put on the market at no increase in price despite the higher cost of manufacture, and thereafter prices were actually reduced and sales volume was lower for the next several years (Rec. pp. 727, 188).

Any significance to the allegations that the brushed product eliminated serious conditions of injury to workmen, etc., is negated by the fact that there is no substantial evidence of such conditions ever existing. The Underwriters Laboratories' records in connection with its inspection service of petitioner's prior material over a long period of years show no complaints whatsoever, and there were only a very few such complaints in connection with the material of respondent's predecessor (Rec. pp. 312-4, 364-5, 909). Petitioner's general sales manager, in announcing the brushed product in 1931, said:

“ * * * 90% of our present customers are well satisfied with the mesh that we have been furnishing them.”
(Def. Ex. 550, Rec. p. 2385, offered p. 202.)

Its vice-president testified that petitioner never had any complaints that the unbrushed material did not come up to the claims of its literature alleging a high degree of smoothness of that material, and one of its salesmen who was called by petitioner to testify could not recall any rejections of such material (Rec. pp. 213, 225).

Lest the references in the petition (p. 8) to holdings of “insistent demand” be mistaken for quotations from the Court of Appeals' decision, it should be noted that they are isolated statements from the Master's report. The Master summed up his views in this connection as follows (Rec. p. 2893):

“Yet, as I see it, the evidence as a whole rather indicates that the metal being supplied was fairly satisfactory and met the demands of the trade, * * *”

Further showing the speciousness of the "insistent demand" argument is the fact that petitioner has disclaimed claim 15 of the Cross patent (Rec. p. 2936). This claim purported to cover "smooth" expanded metal without reference to any process of smoothing (Rec. p. 15). Claim 16, still in issue, is identical therewith except that it defines the product as "*brushed* smooth." There is no evidence, and no conceivable basis for any claim, that "brushed" smoothness is any different from any other kind of smoothness, or that there was ever any demand for brushed expanded metal as distinguished from material made smooth in any other way.

The real reason for the delay in the adoption of brushing as a regular commercial practice was the cost factor. While, as petitioner admits, brushes capable of doing the work had long been known in the art, the brush cost was prohibitive. Brush manufacturers ultimately developed brushes of special analysis steel bristles which wore so much more slowly that brush cost was reduced to permissible limits, and regular commercial brushing was begun shortly afterwards by both parties (Rec. pp. 1821-5, 1919-21, 1925, 688-9). It is not even contended by petitioner that Cross had anything to do with the development of such brushes, and the patent in suit neither discloses nor claims any details thereof.

In this connection, however, it is asserted in the petition (p. 10) that respondent, before the issuance of the Cross patent, secured "information from the manufacturer who had supplied vital parts of petitioner's machine." This is a rank misstatement. It is definitely refuted by petitioner's own witness on the point, an official of the brush company in question. It happened that respondent bought its brushes from the same manufacturer as petitioner had, but there is not a scrap of evidence that respondent even knew that

petitioner was brushing its expanded metal at that time, to say nothing of trying to locate the source of supply of petitioner's brushes. The above-mentioned witness specifically denied that respondent ever sought from his company any information as to petitioner's operations and that his company ever gave respondent any information whatsoever as to the machine or operations of the petitioner. He stated unequivocally that they knew nothing whatever about petitioner's machine (Rec. pp. 405-6).

In any event it is peculiar, to say the least, for petitioner to claim that respondent got information about "vital parts" of petitioner's machine, when the most that such "vital parts" could involve would be the brushes themselves, which petitioner flatly admits (Br. p. 17) were very old in the art.

As to the "open and adverse possession" of the alleged invention referred to in the petition (pp. 9-10) respondent's own development and use prior to the issuance of the patent in suit is a factor of strength rather than weakness in its position. The record clearly shows that when respondent was charged with infringement after issuance of the patent it promptly asserted the defense of invalidity (Rec. pp. 27-8).

Diversity of Opinions Below Is Not Significant.

Of the three opinions below only the three-page Memorandum of the District Court (Rec. pp. 2924-7) was favorable to petitioner. This proposed to overthrow the painstaking work of the Special Master, whose report finding all of the involved patent claims invalid covers pages 2809-2902 of the record. The District Court decision purported to have been based upon "authoritative patent decisions," but it is significant that *it cited no authorities at all*. Moreover, it was based upon a serious misconception of the facts of

the case, for it referred to The American Brass Co. machines as being used *to prepare material for galvanizing* and not to remove danger of injury in handling (Rec. p. 2925). Actually these machines were always employed to remove dangerous burrs and sharp edges (Rec. pp. 828-9, 845-6, 921-2, 938-9, 945). They never had anything to do with the preparation of any material for galvanizing, and there is nothing in the record that even suggests such an idea. In reality, the record shows a situation quite the reverse of that assumed by the District Judge, for it is an admitted practice of *petitioner* to brush some of its expanded metal preparatory to galvanizing the same (Rec. pp. 220, 1850). All told, the District Court decision is neither tenable on its face nor consistent with the record.

The Court of Appeals decision, on the other hand, contains an accurate and thorough discussion of the facts and issues involved and decides those issues with specific reference to controlling authorities (Rec. pp. 2989-98). It is in accord with every one of the Master's recommendations adverse to the patent and in addition sustains the defense of invalidity of claim 16 as not patentably distinct from disclaimed claim 15 (Rec. p. 2996). The petition does not even attempt to demonstrate any error in the sustaining of this further defense.

The situation is well summed up in the words of the Master, quoted with approval by the Court of Appeals (Rec. p. 2993), that "The brush couldn't help itself doing what it (did)," and in the further comment by the Court of Appeals (Rec. p. 2997) that failure to determine just how the brushing should be done "would characterize as dull even an otherwise highly skilled artisan."

On this record it is submitted that the diversity between the ultimate conclusions of the District Judge on the one hand and those of the Special Master and the Court of Ap-

peals on the other does not create a situation requiring review by this Court.

No Concentration of the Industry in the Sixth Circuit.

It is asserted in the petition (p. 7) that the industry is concentrated in the Sixth Circuit, citing the affidavit of Lewis McC. Steenrod filed therewith. Respondent takes direct issue with this assertion and with the averments of the affidavit upon which it is predicated, submitting in refutation an affidavit of William L. Keady, respondent's president, which is reproduced as an appendix to this brief.

As shown by the Keady affidavit, there are several manufacturers of expanded metal in the United States who are subject to patent infringement suits in many, if not all, of the circuits other than the Sixth, by reason of the location of either their manufacturing plants or the states of their incorporation, or by reason of their doing business in various states throughout the country. These additional circuits having such jurisdiction include at least the Third (Milcor Steel Co. and National Gypsum Co., both Delaware corporations); the Fifth (Alabama Metal Lath Co., manufacturing at Birmingham, Alabama); the Seventh (Ceco Steel Products Co., manufacturing at Chicago, Illinois, and Milcor Steel Co., manufacturing at Milwaukee, Wisconsin); the Eighth (Ceco Steel Products Co., a Nebraska corporation); and the Ninth (Truscon Steel Co., manufacturing at Los Angeles, California, as well as at Youngstown, Ohio). In addition, these manufacturers as well as others located in the Sixth Circuit are subject to suit in the many jurisdictions in which they are doing business (see *Neirbo Co. v. Bethlehem Corp.*, 308 U. S. 165), and their distributors and dealers are likewise subject to suit throughout the country.

Petitioner's allegations in this regard are based upon an attempted classification of expanded metal which is not only completely untenable in itself, as the Keady affidavit shows, but the propriety of which is disproved upon the face of the very patent in suit. The Steenrod affidavit (p. 13) purports to exclude "expanded metal which is used for reinforcement purposes such as reinforcement of concrete and plaster" from the types of material with which the patent is concerned. Reference to the patent will show that *both expanded metal lath and expanded metal for use as concrete reinforcement are specifically named as subject to treatment according to the alleged invention*, the concrete reinforcement type being mentioned, in fact, as a particularly outstanding example (Rec. p. 11, lines 9, 55-6, 58-69).

The patent is absolutely unlimited as to the types of expanded metal with which it is concerned. Indeed, it states that it applies to expanded fabrics *of all kinds*. Elimination of injuries to workmen *handling and installing* such fabrics is emphasized fully as much as, if not more than, elimination of injuries resulting from contact with material which is exposed in use, and this of course applies equally to reinforcing material and any other expanded fabrics (Rec. p. 11, lines 70-78).

Thus, even the allegations of *fact* made by petitioner in this connection are disproved.

Petitioner's authorities, *Mackay Co. v. Radio Corp.*, 306 U. S. 86, and *Schriber-Schroth Co. v. Cleveland Trust Co.*, 305 U. S. 47, are also inapplicable because in each of those cases the patents were *sustained* by the Court of Appeals, so that the plaintiff had no incentive to sue in other circuits. Here, however, the question is whether petitioner *could* bring suit elsewhere if it so desired, and it has been shown very definitely that it could.

**Court of Appeals Decision Not Based on Misinterpretation
of Schriber-Schroth Decisions.**

Aside from the above-mentioned points, petitioner's case is primarily based upon the premise that the Court of Appeals, in the case at bar, "misunderstood," "misapplied" and "misinterpreted" the decisions of this Court in *Schriber-Schroth Co. v. Cleveland Trust Co.*, 305 U. S. 47 and 311 U. S. 211 (see Pet. & Br. pp. 7, 9, 10, 25-7). Such a position is beyond understanding, for the only reference to these authorities in the Court of Appeals decision is at the very end thereof (Rec. p. 2998) where they are merely mentioned in connection with that Court's own decisions in the same cases and the statement that

" * * * commercial success alone or the apparent solution of a long perceived problem will not of itself vitalize an otherwise invalid patent."

Surely petitioner cannot contend that such a holding is in any way erroneous. The decision of this Court in *Thropp's Sons Co. v. Seiberling*, 264 U. S. 320, 330, for example, is to the same effect. This rule is so well established and so clearly a salutary one that the citation of other authorities should be wholly unnecessary.

No other mention of any *Schriber-Schroth* case appears in the Court of Appeals decision herein except at page 2994 of the record, and there it is only *its own* decisions (*Cleveland Trust Co. v. Schriber-Schroth Co.*, 92 F. (2d) 330 and 108 F. (2d) 109) that the Court has reference to. This discussion follows a definite holding of lack of invention in the patent in suit and is actually nothing more than *obiter*. In any event, the discussion of these cases is only on the side of greater leniency toward petitioner's case, because the substance of it is that even if the patent in suit were measured by the more liberal standards applied by the

Court of Appeals in the *Schriber-Schroth* cases it would still have to be held invalid for want of invention. By no stretch of the imagination can this holding be twisted into an erroneous interpretation or application of this Court's decisions, as petitioner urges.

Moreover, the Court below indicates (Rec. p. 2994) a more liberal view on the question of invention than that set forth by the Court of Appeals for the Second Circuit in *Picard v. United Aircraft Corp.*, 128 F. (2d) 632 (certiorari denied . . . U. S. . . . 87 L. Ed. 38). Here again, therefore, it is clear that the Court of Appeals has by no means applied the most rigorous standards of invention in invalidating the patent in suit.

In this same connection petitioner complains (Br. p. 26) that the Court of Appeals failed to apply the authority of *Paramount Publix Corp. v. American Tri-Ergon Corp.*, 294 U. S. 464, saying:

"* * * Although not adverting to the *Paramount* case by name, the Court of Appeals considered the argument and rejected it, primarily because of the decisions of this Court in the *Schriber-Schroth* cases,"

This statement is directly contrary to fact, for the Court of Appeals squarely predicated its decision upon the *Paramount* case, specifically citing the same, thus (Rec. p. 2993):

"* * * the prompt recognition by the Supreme Court in *Paramount Corp. v. Tri-Ergon Corp.*, 294 U. S. 464, that sound film patents but applied the skill and wisdom of photography, should put a period to the fanciful distinction here asserted."

Also cited in support of this holding were the decision of this Court in *Cuno Corp. v. Automatic Devices Corp.*, 314 U. S. 84, 91 and 92, and several decisions of the Court below, and the inapplicability of the most favorable case cited

by petitioner on the point involved, *Lakewood Engineering Co. v. Walker*, 23 F. (2d) 623, was clearly demonstrated.

The fact is, therefore, that the Court of Appeals decided this case in reliance upon the very authority which petitioner now asserts was not even adverted to by name in the decision, specifically distinguishing the principal other authorities relied upon by petitioner, and without even mentioning the *Schriber-Schroth* decisions of this Court except in reference to the elementary proposition that commercial success alone cannot sustain a patent. Since the *Schriber-Schroth* decisions played no substantial part in determining the Court of Appeals' views in the case at bar, it is manifest that petitioner's allegations of misinterpretation and misapplication of those authorities are utterly without foundation.

No Failure to Apply This Court's Decisions.

The respective subdivisions of petitioner's contentions in this regard are answered as follows:

(a) (Pet. & Br. pp. 8-9, 27-9.) It has been demonstrated *supra* that petitioner is in error both in contending that the Court of Appeals decision herein was predicated upon a misinterpretation of this Court's decisions in the *Schriber-Schroth* cases and in denying that the Court of Appeals followed or even made any reference to the *Paramount* case, 294 U. S. 464.

Expanded Metal Co. v. Bradford, 214 U. S. 366, is no authority for the proposition that the filing of a long-felt want will sustain a patent except in a doubtful case. It is clear that the Court of Appeals had no doubt as to the invalidity of the patent here in suit, and in view of the authorities already cited herein the patent could not be sustained upon the instant contentions of petitioner even if such contentions were well founded in fact.

It is further stated by petitioner (Br. p. 28) that the decision of the Court of Appeals is not based upon the testimony of any witness that what Cross did was within the expected skill of the art. On the contrary, there is ample testimony to that effect (Rec. pp. 100, 105, 118, 161, 470, 471, 482, 1117).

(b) (Pet. & Br. pp. 9-10, 29-30.) This Court's decision in *Krementz v. The S. Cottle Company*, 148 U. S. 556, is urged by petitioner as applicable because of a statement made by the president of respondent's predecessor in the case at bar. In the case cited, however, it was emphasized that the prior attempt and failure to solve the problem were *by a highly skilled artisan*. There is no such evidence in the present case, and in fact the contrary appears (Rec. p. 571). Moreover, it is apparent from the context of the statements cited by petitioner that the factor of *cost* played an important part in the appraisal of the situation (Pl. Ex. 23, Rec. p. 1973, offered p. 308). The author of those statements died long before the trial of this case (Rec. p. 306), so respondent had no opportunity to get any further elucidation from him.

(c) (Pet. & Br. pp. 10, 30-31.) The authority of *Hobbs v. Beach*, 180 U. S. 383, has no bearing as insisted by petitioner, because it involved the changing of a machine so as to make it perform *a wholly different function*. It is difficult to see how petitioner can seriously contend that the removal of burrs and sharp edges from expanded metal is in anywise a different function from the removal of burrs and sharp edges from other sheared metal sheets, which has been definitely shown (*ante*, p. 4) to be one of the functions of the prior use machines of The American Brass Co. and also a function which the Buckman patent machines would be readily capable of performing. It will be remembered that the Buckman machines are *brushing* machines

embodying the same brush arrangement as the Cross patent, rather than merely machines for applying scouring powder as represented by petitioner.

The most that can be said for the patent here in suit is that it is applied to the treatment of the same material in a *form* somewhat different from the specific references of the prior art, without producing any new character of result. This is obviously not inventive. *Cuno Corp. v. Automatic Devices Corp.*, 314 U. S. 84, 91, and cases cited; *Concrete Appliances Co. v. Gomery*, 269 U. S. 177, 184; *Howe Machine Co. v. National Needle Co.*, 134 U. S. 388, 397-8.

(d) (Pet. & Br. pp. 10, 31-3.) The cases cited by petitioner in support of its contention that Cross was entitled to the benefits of the work done by The Manufacturers Brush Co. are clearly inapplicable because the Brush Co. did its work without the benefit of any instructions or suggestions from Cross (see *ante*, pp. 4-5). In *Agawam Co. v. Jordan*, 7 Wall. 583, 602, only "discoveries ancillary to the plan and preconceived design of the employer" were held to redound to the latter's benefit. The record at bar is clear that there was no such "plan and preconceived design" in this case. The situation in *Minerals Separation, Limited v. Hyde*, 242 U. S. 261, was even more remote, the Court saying (p. 270):

"* * * The record shows very clearly that the patentees planned the experiments in progress when the discovery was made; that they directed the investigations day by day, conducting them in large part personally and that they interpreted the results."

Moreover, the *Agawam* case contains a positive holding fatal to petitioner's case, as follows (7 Wall., at p. 603):

"* * * But where the suggestions go to make up a complete and perfect machine, embracing the substance of all that is embodied in the patent subse-

quently issued to the party to whom the suggestions were made, the patent is invalid, because the real invention or discovery belonged to another."

As previously pointed out (*ante*, p. 5), the recommendations of The Manufacturers Brush Co. to petitioner actually embodied the essential features and details of the machine and operation upon which is based the patent subsequently taken out in the name of Cross.

No Conflict with Decisions of Other Circuits.

There is likewise no substance to the claims advanced in the petition to the effect that the Court of Appeals decision herein is in conflict with the decisions of other Circuit Courts of Appeals. Again answering petitioner's contentions in corresponding subdivisions, respondent submits:

(a) (Pet. p. 10.) Nothing is involved here but another reiteration of petitioner's contentions referring to the *Paramount* and *Schriber-Schroth* cases. Those contentions have already been fully answered herein.

(b) (Pet. p. 11.) Reference to the decision in *Leibing Automotive Devices, Inc. v. Wildermuth*, 104 F. (2d) 411, 412 (C. C. A. 2), will show that there is no rule in the Second Circuit such as that urged by petitioner on citation of *Kurtz v. Belle Hat Lining Co.*, 280 Fed. 277. Going still further, see *Picard v. United Aircraft Corp.*, 128 F. (2d) 632, 636.

(c) (Pet. p. 11.) *White v. Converse*, 20 F. (2d) 311, and *Traitel v. Hungerford*, 18 F. (2d) 66, utterly fail to establish any Second Circuit rule that adaptations need not involve any invention to sustain a patent. *White v. Converse* makes no specific reference to invention or lack of invention in the adaptations themselves and simply purports to follow *Traitel v. Hungerford*, which held that a

patent might be supported on the basis of slight structural changes *only when such changes presuppose a use not discoverable without inventive imagination*. In the case at bar the Court of Appeals has held (Rec. p. 2992) that the adaptation required in the case of the Buckman patents "would have consisted merely of adjustments quite obviously within the skill of the art" and (p. 2993) that the allegation of new use is "but a play upon words" as well as being inconsistent with the admissions of petitioner's expert, and accordingly found no invention in the subject matter in issue. Certainly there is nothing in this holding inconsistent with the Second Circuit cases cited by petitioner.

Moreover, the same rule was very clearly stated in *Hobart Mfg. Co. v. Landers, Frary & Clark*, 26 F. Supp. 198, 202 (D. C.), affirmed on opinion below, 107 F. (2d) 1016 (C. C. A. 2), and it is plain from the recent decision in *Picard v. United Aircraft Corp.*, *supra*, that the Second Circuit now applies a much more stringent test.

The petition further cites *Rousso v. City Towel Supply Co.*, 242 Fed. 655, as setting forth "the rule in the Seventh Circuit." This was not a Seventh Circuit case at all and was not even a Court of Appeals decision. It was a decision of the District Court for the Southern District of California. Even so, it did not hold as petitioner represents. It said nothing about adaptations not inventive in themselves, but rather sustained the patent only on the basis of *substantial* changes.

(d) (Pet. p. 11.) Two cited decisions of the Court of Appeals for the District of Columbia are alleged by petitioner to support its claim that Cross was entitled to the benefit of the work done by The Manufacturers Brush Co. One of these is *Massey et al. v. Ridge*, 270 Fed. 879, which was an interference proceeding in which the party Ridge

had disclosed the invention to the opposing party. The Court held that Ridge had a *complete conception* of the invention prior to his discussion of it with Massey et al. and accordingly held that he was entitled to the patent. *Orcutt v. McDonald*, 27 App. D. C. 228, the other of the cases cited by petitioner, applied precisely the rule of *Agawam Co. v. Jordan*, already discussed herein (*ante*, p. 16). Clearly, these authorities have no applicability in the case at bar, where it definitely appears that no conception of the alleged invention was transmitted by Cross to The Manufacturers Brush Co.

Element of Public Importance Entirely Lacking.

In view of the foregoing demonstration that the decision of the Court of Appeals in no wise misinterprets or fails to apply the applicable decisions of this Court or conflicts with decisions of other Circuit Courts of Appeals, and that there is no concentration of the involved industry in the Sixth Circuit, this case cannot assume the proportions of public importance urged in the petition (pp. 11-12).

The controlling issue in the case is that of invention, which was urged by petitioner below to be a question of *fact*, to be determined according to the evidence, citing *Thomson Spot Welder Co. v. Ford Motor Co.*, 265 U. S. 445, and *Eibel Process Co. v. Paper Co.*, 261 U. S. 45. Manifestly such an issue is not a matter of public importance, particularly when, as here, the Court of Appeals and the Special Master have found alike with respect to it on the basis of the most carefully considered opinions, and the only contrary opinion is that of the District Court which fails to cite any authorities or to state any substantial reasons in support of its conclusion.

Conclusion.

It has been shown herein that the petition at bar is ill founded in both law and fact. The only question that could be resolved by this Court is that of validity of the patent in suit, hinging upon the question of invention. This cannot involve any important issue of general patent law, and in such circumstances there is no ground for issuance of the writ of certiorari. *Keller v. Adams-Campbell Co.*, 264 U. S. 314, 319; *Layne & Bowler Corp. v. Western Well Works*, 261 U. S. 387, 393. Accordingly, the petition should be denied.

Respectfully submitted,

ARTHUR A. OLSON,

ALBERT H. PENDLETON,
Counsel for Respondent.





APPENDIX.

IN THE
SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1942

No. 568.

**THE CONSOLIDATED EXPANDED METAL
COMPANIES,**

Petitioner,

vs.

UNITED STATES GYPSUM COMPANY,
Respondent.

AFFIDAVIT OF WILLIAM L. KEADY.

STATE OF ILLINOIS, }
COUNTY OF COOK. } ss:

William L. Keady, being duly sworn, deposes and says
as follows:

I am President of United States Gypsum Company, respondent in the above-entitled case, and have successively held various managerial and executive positions with that company since 1924. I am familiar with the expanded metal business in the United States and with the expanded metal products of numerous manufacturers thereof.

I have read the affidavit of Lewis McC. Steenrod filed with the petition in the above-entitled case. The alleged classification of expanded metal into the two classes set

forth in that affidavit is not in accordance with any classification recognized in the expanded metal industry. The various types of expanded metal named in each of said alleged classes cover a wide range of weights, gauges and physical characteristics. Expanded metal of the type used for concrete reinforcement is ordinarily of heavy gauge and large mesh, whereas that used for plaster reinforcement or lathing is of relatively light gauge and small mesh. The type of expanded metal used for brake shoe reinforcement is intermediate between expanded metal lath and expanded metal for concrete reinforcement and is widely different in mesh size and gauge from both, being actually identical with certain of the materials enumerated in the alleged class (b) of the aforesaid Steenrod affidavit. The various types included in this latter alleged classification likewise cover a wide range of weights, gauges and other physical characteristics. All of the types of material included in each of the said alleged classes (a) and (b) are comprehended by the generic term "expanded metal," particularly as that term is used in the Cross patent No. 1,950,372 involved in this suit, in which specific reference is made to "expanded metal lath" and "plaster lathing" (p. 1, lines 9, 69) and also "concrete reenforcement" (p. 1, lines 55-6), and general reference is made to "expanded fabrics of all kinds" (p. 1, line 73).

To my knowledge there are numerous concerns which manufacture various types of expanded metal in the United States outside of the Sixth Circuit or are incorporated in states outside that circuit. Among these are the following concerns which manufacture such products at the places respectively named:

Alabama Metal Lath Co., at Birmingham, Alabama.

Ceco Steel Products Co., at Chicago, Illinois.

Milcor Steel Co., at Milwaukee, Wisconsin.

National Gypsum Co., at Niles, Ohio.

Truscon Steel Co., at Youngstown, Ohio, and Los Angeles, California.

On the basis of information which I have every reason to consider reliable, I believe that in every one of the circuits at least some of these concerns, as well as other manufacturers located in the Sixth Circuit, are doing business or have expanded metal products on sale through distributors or dealers, and that the said Ceco Steel Products Co. is a Nebraska corporation and Milcor Steel Co. and National Gypsum Co. are Delaware corporations. The above-mentioned products of the concerns named include in every case expanded metal lath and at least in the case of Milcor Steel Co. include in addition other types of expanded metal.

WILLIAM L. KEADY.

Subscribed and sworn to before me this 23rd day of December, 1942.

HELEN RATH,
Notary Public.

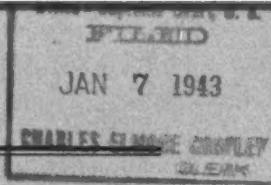
My commission expires April 26, 1944.

(NOTARIAL SEAL)

REPLY BRIEF



(31) 30



Supreme Court of the United States

OCTOBER TERM, 1942.

NO. 568.

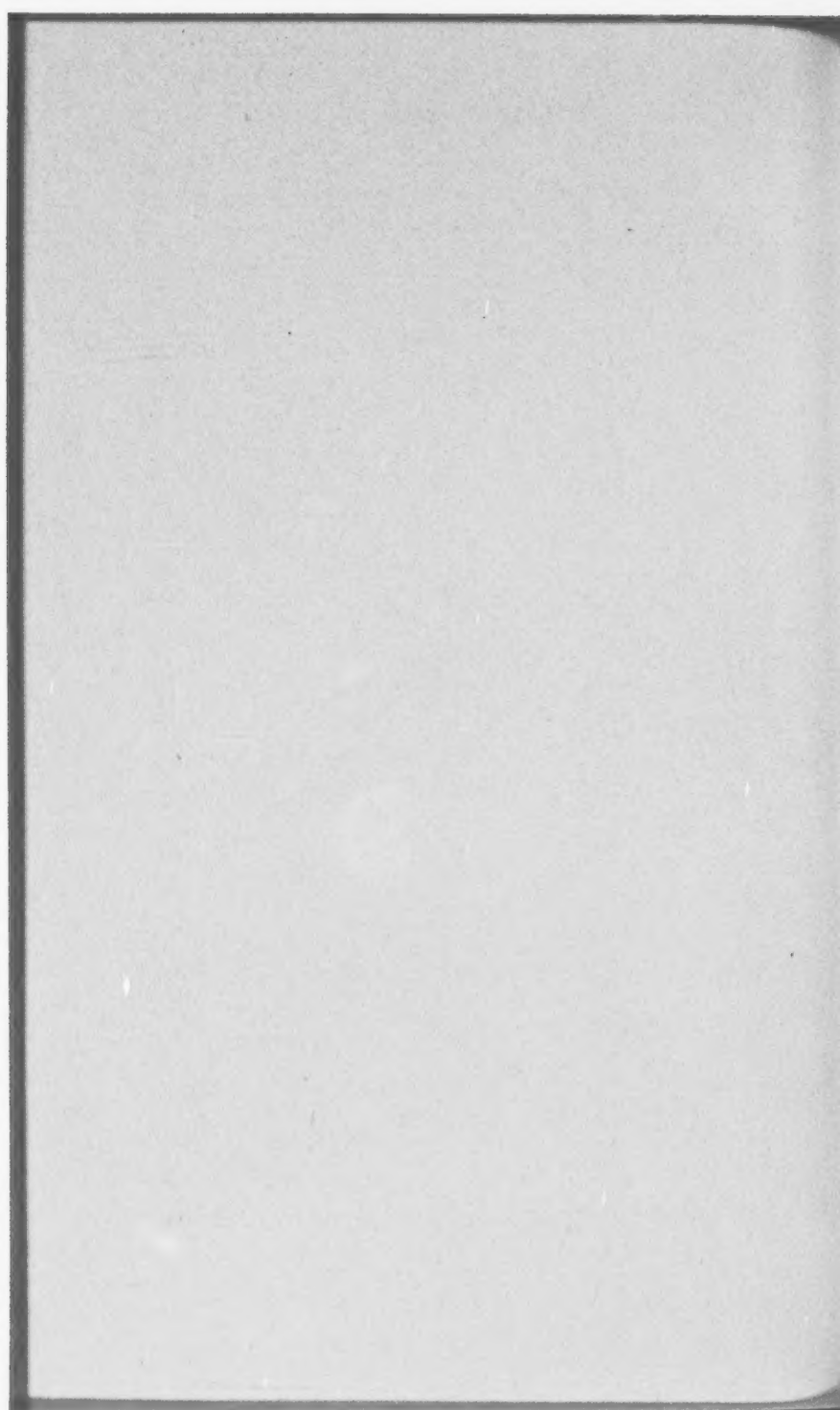
THE CONSOLIDATED EXPANDED METAL
COMPANIES, Petitioner,

v.

UNITED STATES GYPSUM COMPANY, Respondent.

REPLY BRIEF FOR PETITIONER ON PETITION
FOR WRIT OF CERTIORARI.

WALTER J. BLENKO,
ARTHUR J. HUDSON,
Counsel for Petitioner.



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Supreme Court of the United States

OCTOBER TERM, 1942.

NO. 568.

THE CONSOLIDATED EXPANDED METAL
COMPANIES, Petitioner,

v.

UNITED STATES GYPSUM COMPANY, Respondent.

REPLY BRIEF FOR PETITIONER ON PETITION FOR WRIT OF CERTIORARI.

Summary of the Undisputable and Controlling Facts.

A detailed reply to respondent's assertions of fact is submitted herewith as an appendix. We give below a brief resume of the controlling facts about which there can be no dispute:

(a) The problem of making expanded metal free from dangerous burrs and sharp edges existed for more than *forty years* before its solution by Cross¹. Cross was the first to solve it².

(b) There was an "insistent demand" for a solution of the problem over the entire period, a demand emphasized by the fact that human safety was involved³.

(c) The prior art reference asserted by respondent to be the closest⁴—the Buckman patent—existed for

¹ Petition, pp. 2-4; *infra*, pp. 19-22.

² Petition, pp. 3-4; *infra*, pp. 22-3.

³ Petition, p. 2; *infra*, pp. 19-22.

⁴ Rec. pp. 541, 2992.

thirty-seven years⁵ before the solution of the problem⁶ but no one saw in it any way of meeting the insistent demand. The requisite wire brushes had been in existence even longer⁷.

(d) Many skilled workers in the art, including officers and employees of respondent's predecessor⁸, attacked the problem but failed to solve it. The president of respondent's predecessor said it was "impossible"⁹ of solution and attributed the failure "to the peculiarity of the material itself and the shape of the mesh"⁹.

(e) The Court of Appeals conceded that the Buckman machine required "adaptation"¹⁰ in order to make it suitable to deburr expanded metal. The Buckman machine is simply for scouring the surfaces of solid (imperforate) sheet metal for removing "loose scales or other impurities clinging thereto"¹¹, "just like a housewife polishing her silver plate"¹², and uses the *tips* of the brush bristles, while Cross utilizes a novel *side* action of the brush bristles¹³ to effect metal removal¹⁴.

(f) The Court of Appeals conceded that Cross had made an advance but said it "must be construed as within the skill of the art rather than invention"¹⁵, *despite the fact that the skilled men in the art failed to make it over a forty year period, although spurred by the insistent demand.*

⁵ Rec. p. 2400.

⁶ Rec. p. 1726.

⁷ Rec. p. 2394; Petition, p. 17; Respondent's Brief, p. 3.

⁸ Rec. pp. 727, 1973.

⁹ Rec. p. 1973.

¹⁰ Rec. p. 2992.

¹¹ Rec. p. 2402, ll. 23-4.

¹² Rec. p. 542.

¹³ Rec. pp. 13, 92-3.

¹⁴ Rec. pp. 13, 81.

¹⁵ Rec. p. 2994.

(g) The Court of Appeals, after stating "Much difficulty has, of course, been experienced by the courts in determining what improvements lie within the expected skill of the art"¹⁵, referred to its own decisions in the *Schriber-Schroth* cases, said that "Older cases are not very helpful", that "The patent law is presently in a state of flux" and that "Much water has flowed over the patent dam"; and, although noticing "the urgent insistence of the appellee [petitioner] upon the existence of a long felt need and alleged commercial success promptly following manufacture responding to the disclosures of the patent"¹⁶, rejected petitioner's contention because of what had "been made forcibly clear to us by the decisions of the Supreme Court in *Schriber-Schroth v. Cleveland Trust Co.*, 305 U.S. 47, and 311 U.S. 211, when considered in the light of our holdings in the same cases, 92 Fed. (2d) 330, and 108 Fed. (2d) 109"¹⁷.

It is plain, therefore, that the Court of Appeals has jettisoned the decisions prior to *Schriber-Schroth* that are favorable to a finding of invention, and particularly the rule that "Where the method or device satisfies an old and recognized want, invention is to be inferred, rather than the exercise of mechanical skill"¹⁸.

Commercial Aspects of the Invention.

(a) Respondent seeks to minimize the fact that there was an "insistent demand"¹⁹. The Court of Appeals accepted the fact²⁰, as did the District Court²¹, and as the Master found, the latter saying: "The evidence is

¹⁶ Rec. p. 2997.

¹⁷ Rec. p. 2998.

¹⁸ *Paramount Publix Corp. v. American Tri-Ergon Corp.*, 294 U.S. 464, 474.

¹⁹ Respondent's Brief, p. 6.

²⁰ Rec. p. 2997.

²¹ Rec. p. 2927.

convincing, in fact, there is no dispute"²², that for many years there had been much objection to the sharp edges and burrs and "That for many years there had been an insistent demand for such metal without the sharp edges is very clear from the evidence"²².

The two quotations on page 6 of respondent's brief in no way affect the situation. It is inevitable in any art that, even though a demand for something better exists, the trade must get along with what is available until the demand is met and make the best of it.

(b) Respondent asserts that "The real reason for the delay in the adoption of brushing as a regular commercial practice was the cost factor"²³. Significantly, it cites no supporting evidence and its assertion is in striking contrast with the *ante litem motam* statement of respondent's predecessor that it had investigated the possibility of brushing but failed, "principally due to the peculiarity of the material itself and the shape of the mesh"²⁴.

It may readily be conceded that here, as in any industrial operation, cost is a factor of some moment. The Cross patent teaches and claims brushing lengthwise of the diamonds and penetration of the bristles to the median plane of the sheet (see drawing at p. 18 of the Petition). If these teachings be followed, the mesh can be made burr-free despite "the peculiarity of the material"²⁴, and *at low brush cost*²⁵.

²² Rec. p. 2850.

²³ Respondent's Brief, p. 7.

²⁴ Rec. p. 1973.

²⁵ Rec. p. 1736.

Diversity of Opinions Below.

(a) Respondent is well aware of the fact that the decision of the District Court followed after the submission of a brief and argument for petitioner essentially the same as that advanced in the Court of Appeals and that the "authoritative patent decisions" urged on the District Court were the same as were urged by petitioner in the Court of Appeals, namely, the *Paramount* case and the prior decisions of this Court cited therein; 294 U.S. 464, 474. So there is in fact a direct conflict between the District Court and the Court of Appeals as to the applicability of the *Paramount* doctrine.

(b) Respondent alleges a misconception of the facts by the District Court because of the reference in its opinion to the preparation of material for "galvanizing"²⁶. This reference was obviously to the Buckman patent—concededly the closest reference—which shows the preparation of material for coating with tin.

(c) The comment of the Court of Appeals that failure to determine how to apply the brush "would characterize as dull even an otherwise highly skilled artisan"²⁷ is illuminating of the fundamental error in the Court of Appeals' decision. It is a notable instance of the *ex post facto* reasoning condemned by this Court in *Expanded Metal Co. v. Bradford*, 214 U.S. 366, 381, cited with approval in the *Paramount* case. The question is not whether the thing appears simple *now*, but whether it was within the expected skill of the workers in the art *before they had the benefit of Cross' disclosure*. That it was not within their expected skill is shown by the fact that the problem existed unsolved for forty years despite an insistent demand and persistent attempts at its solution.

²⁶ Respondent's Brief, pp. 8-9.

²⁷ Respondent's Brief, p. 9; Rec. p. 2997.

Concentration of the Industry in the Sixth Circuit.

(a) Filed herewith and printed at page 13 is a reply affidavit of Lewis McC. Steenrod which disposes of the allegations of the Keady affidavit²⁸.

(b) In its effort to show that there is no concentration of industry in the Sixth Circuit, respondent has found it necessary²⁹ to advance the extreme argument that petitioner might bring suits against distributors and dealers, a contention which is obviously unsound insofar as the process and apparatus claims are concerned. Suit on these claims can only be maintained against the manufacturer himself. *U. S. Code, Title 28, Section 109; Colgate & Co. et al. v. Proctor & Gamble Manufacturing Co.* (D.C. E.D. N.Y.), 25 F. 2d 160.

(c) Respondent urges that *Mackay Co. v. Radio Corp.*, 306 U.S. 86, and *Schriber-Schroth Co. v. Cleveland Trust Co.*, 305 U.S. 47, are inapplicable here "because in each of those cases the patents were *sustained* by the Court of Appeals, so that the plaintiff had no incentive to sue in other circuits"³⁰. Respondent then says that "it has been shown very definitely" that petitioner could bring suit elsewhere "if it so desired". This contention is ill founded, as is shown by the foregoing paragraph and by the Steenrod reply affidavit, and as is tacit from the failure of the Keady affidavit to assert that there has been or is even likely to be any infringement outside of the Sixth Circuit. Quite apart from this, however, we submit that respondent's argument as to the *Mackay* and *Schriber-Schroth* cases is untenable. In the *Mackay* case the petitioner was "the only competitor of respondent in the business of world wide public radio communi-

²⁸ Respondent's Brief, p. 21.

²⁹ Respondent's Brief, p. 10.

³⁰ Respondent's Brief, p. 11; emphasis by respondent.

cation" so that, "incentive" or not, there was no probability of further litigation. Nor can we believe that this Court, as respondent seems to suggest, has one standard for the granting of the writ to *infringers* unsuccessful in the lower courts and another more rigid standard for the granting of the writ to *patentees* unsuccessful in the lower courts.

Misinterpretation of the Schriber-Schroth Decisions by the Court of Appeals.

(a) The factual summary at the beginning of this reply brief succinctly shows the misinterpretation. The vice of respondent's argument lies in its undue generalization of the issue. Of course we do not contend that mere commercial success or the mere solution of a long perceived problem must spell *validity* in every case. We do contend, consonant with the rule of the *Paramount* case, that the existence of a long felt need, the persistent trials and failures of men working in the art to satisfy that need, and the ultimate satisfaction by the patentee spells *invention*. The Court of Appeals held that the advance was "within the expected skill of the art" and it is precisely on this point that the conflict with the *Paramount* case and the misinterpretation of the *Schriber-Schroth* cases appears.

(b) The reference by the Court of Appeals to the *Paramount* case, as quoted by respondent³¹, was in connection with a discussion of analogous and non-analogous arts and not with the legal principles applicable to a case of long felt want and ultimate solution. And in the *Paramount* case the fact was that the want did not exist unsatisfied for a long period of time, as here. On the contrary, the solution of the problem followed promptly after it came into existence.

³¹ Respondent's Brief, p. 13.

(c) *Cuno Corp. v. Automatic Devices Corp.*, 314 U.S. 84, enounces no rule in conflict with the rule of the *Paramount* case which we urge here. This is plain from the last sentence of Mr. Chief Justice STONE's concurring opinion, saying "The [*Cuno*] case is therefore not one for the application of the doctrine that commercial success or the manifest satisfaction of a felt need will turn the scale in favor of invention." It seems plain, therefore, that if the Court of Appeals applied the *Cuno* case in the way that respondent urges, there is all the more reason for granting the writ so as to correct its error.

Failure to Apply Decisions of This Court.

(a) Respondent's discussion of *Expanded Metal Co. v. Bradford*, 214 U.S. 366³², begs the entire question. Respondent's argument is in substance that the Court of Appeals held there was no invention and therefore the *Expanded Metal* case is inapplicable, whereas the case is authority for the proposition that, in circumstances such as those at bar, a holding of invention should follow. Similarly all of the testimony cited by respondent³³ in support of its argument assumes that the first all-important step—visualizing the use of a brushing machine for the removal of burrs and sharp edges from inside the diamonds of expanded metal—had already been taken. But this assumption is refuted by the history of the industry.

(b) *Krementz v. The S. Cottle Company*, 148 U.S. 556, is applicable *a fortiori*. Respondent's predecessor was a skilled organization³⁴. Its attempts to solve the problem were not made merely by its president but by

³² Respondent's Brief, pp. 14-5.

³³ Respondent's Brief, p. 15.

³⁴ Rec. p. 570.

its engineer, Mr. Baker³⁵, and Mr. Prange, its factory superintendent³⁶. Respondent's predecessor "tried every known means of overcoming this trouble" and "spent a lot of money in experimental work" but failed³⁷.

(c) The difference in function between the machine of the patent held valid in *Hobbs v. Beach*, 180 U.S. 383, and the prior art device was surely not as great as the difference in function between the machine of the Cross patent and the Buckman machine³⁸.

The difference between the Cross invention and the American Brass Company machines is not merely a difference in form of the material under treatment, as respondent asserts³⁹, because in the Cross machine there is a wholly novel brush action effecting metal removal⁴⁰, whereas in the ordinary use of the American Brass Company machines there was no metal removal even of soft copper fins on the peripheries of the imperforate slabs⁴¹. Consequently, there is a new character of result. And, quite apart from this, it is plain that the inherent nature of expanded metal, and the location of the burrs inside the diamonds, presented a problem that baffled the art (it will be recalled that respondent's predecessor failed "principally due to the peculiarity of the material itself and the shape of the mesh"⁴²), so invention may well reside in the application of brushes to such a material; *Hobbs v. Beach*, *supra*.

³⁵ Rec. p. 1971.

³⁶ Rec. p. 1962.

³⁷ Rec. p. 1973.

³⁸ Petitioner's Main Brief, pp. 30-1.

³⁹ Respondent's Brief, p. 16.

⁴⁰ Rec. pp. 92-3; *infra*, p. 16.

⁴¹ Rec. p. 1865.

⁴² Rec. p. 1973.

(d) That phase of the rule of *Agawam Co. v. Jordan*, 7 Wall. 583, that favors the validity of the patent is applicable here. Even the most casual comparison of the letters of The Manufacturers Brush Co.⁴³ with the specification of the Cross patent will show that respondent's contention has no factual support.

Conflict of Decision With Other Circuit Courts of Appeals.

(a) The decisions of the Circuit Court of Appeals for the Second Circuit in *Leibing Automotive Devices, Inc. v. Wildermuth*, 104 F. 2d 411, and *Picard v. United Aircraft Corp.*, 128 F. 2d 632⁴⁴, are not in conflict with and do not overrule *Kurtz v. Belle Hat Lining Co.*, 280 F. 277. And obviously they cannot overrule this Court's decision in *Krementz v. The S. Cottle Company*, 148 U.S. 556⁴⁵.

(b) Far from departing, as respondent suggests⁴⁶, from the doctrine of *Traitel v. Hungerford*, 18 F. 2d 66, the Court of Appeals for the Second Circuit in *Picard v. United Aircraft Corp.*, *supra*, has indicated adherence thereto. At page 636 of the latter decision that court reiterates its rule that "the safest test is to try to reconstruct the history of the art before and after" the appearance of the putative inventions "and judge from that how far they demanded exceptional talents". The court then went on to show the inapplicability of the rule to the case then before it in that (a) Heron, one of the prior workers in the art, achieved some measure of success, (b) that the decisive prior art disclosure existed for only four years before Picard's application and (c)

⁴³ Respondent's Brief, pp. 5, 17.

⁴⁴ Respondent's Brief, p. 17.

⁴⁵ Petition, p. 9.

⁴⁶ Respondent's Brief, p. 18.

that the skilled workers in the art had not in that four year period turned their attention to the problem because they were fully engaged on more important work. Nor was it indicated that there had been any "insistent demand". But in the case at bar the record shows without dispute that the most pertinent prior art reference existed for *thirty seven years*, that there *was* an insistent demand, that the skilled workers in the art did attempt to solve the problem and that they failed and even characterized it as impossible of solution.

(c) We regret the citation of *Rousso v. City Towel Supply Co.*, 242 F. 655, as a decision of the Seventh Circuit. Respondent is correct in saying that it is a District Court decision in the ~~Tenth~~ ^{Tenth} Circuit. However, although not a Court of Appeals decision, it is indicative of the divergence of view in the inferior courts.

Public Importance.

Granting that invention in any particular case is a question of fact, it is one "to be determined, however, by rules of law"; WOOLLEY, J., in *Radiator Specialty Co. v. Buhot* (C.C.A. 3), 39 F. 2d 373, 376. Recognition of the rule just stated is tacit in the regular granting of the writ of certiorari by this Court to review the legal principles applicable to the question of invention presented in any particular case. The matter presented here raises clear-cut questions of law.

Keller v. Adams-Campbell Co., 264 U.S. 314⁴⁷, was a case which, upon examination, was found to present no issue except the question of infringement, and *Layne & Bowler Corp. v. Western Well Works*, 261 U.S. 387⁴⁷, was a case which, upon examination, revealed no conflict such as had been supposed to exist. Neither deci-

⁴⁷ Respondent's Brief, p. 20.

sion is controlling here. Subsequent decisions of this Court cited at page 16 of our brief in support of the petition are believed to be more in point.

Respectfully submitted,

WALTER J. BLENKO,
ARTHUR J. HUDSON,
Counsel for Petitioner.

January 6, 1943.

REPLY AFFIDAVIT OF LEWIS McC. STEENROD.

State of West Virginia }
County of Ohio } ss.:

Lewis McC. Steenrod, having been first duly sworn according to law, deposes and says as follows:

1. I am the Lewis McC. Steenrod who filed an affidavit in support of the petition for certiorari herein. I have read the affidavit of William L. Keady, filed with the brief for respondent in opposition to said petition.

2. The classification of expanded metal as given in my original affidavit is a proper one and is in accordance with the evidence in this case as appears from pages 187 and 206 of the record.

3. "Industrial Mesh" such as is used for the making of machinery guards, waste baskets, window guards and the like is exposed in use; whereas, metal lath, concrete reinforcement and brake shoe reinforcement are embedded in plaster, concrete or cast iron and are not thereafter exposed to human contact. It is quite true that the Cross invention is usable for the purpose of brushing metal going into these latter uses, but its importance lies in the treatment of industrial mesh which, as stated, constitutes a continuous menace (if not brushed) throughout its life and which must be cut and shaped by manual work in fabricating it into articles of commerce. It was here that many accidents occurred with unbrushed mesh. The openings in metal lath are diamond shaped and rarely exceed 9/16" in length and 5/16" in width and are therefore so small that workmen do not get their fingers inside of the diamonds where their fingers can be cut by the burred edges, whereas in Industrial Mesh the openings are generally large enough that the fingers readily enter the mesh and, in the case of unbrushed metal, are subject to laceration.

4. There is in fact a concentration of the "Expanded Metal" industry in the Sixth Circuit. Metal Lath is not even called "expanded metal" in the trade. It is not made by the Golding method. Petitioner cannot bring suit for infringement against any of the concerns enumerated in the Keady affidavit. None of them brushes expanded metal and it is improbable that any of them will. In any event, Alabama Metal Lath Company, Ceco Steel Products Company and National Gypsum Company make metal lath only. The business of Milcor Steel Company is primarily metal lath. It has one machine that is not a metal lath machine, but the product of that machine is not classified as Industrial Mesh. Milcor Steel Company purchases its requirements for brushed expanded metal from petitioner. Truscon Steel Company has no facilities at its Los Angeles plant for making expanded metal. It has some equipment for this purpose at Youngstown, Ohio, but, as stated, it does not brush any expanded metal and from time to time it has purchased brushed expanded metal from petitioner. Moreover, as stated in paragraph 4 of my original affidavit, it would be impossible at this time for any manufacturer to construct a machine for practicing the invention.

(Signed) LEWIS MCC. STEENROD.

Sworn to and subscribed before me, a Notary Public in and for the said County and State, this 2 day of January, 1943.

(Signed) RUSSELL WEST,
Notary Public.

[NOTARIAL SEAL]

My Commission Expires July 28, 1951.





APPENDIX.**Petitioner's Specific Replies to Respondent's "Counter-Statement of Facts" (Br. pp. 1-8).**

Respondent charges that "the essential facts of the case are considerably obscured and distorted in the petition" and purports to give "a more accurate and informative statement" (Br. p. 1). The converse is true. This will be demonstrated below by quoting respondent's principal misstatements and referring in connection with each thereof to the record.

I.

Respondent's statement (Br. p. 2): "These burrs and sharp edges [of expanded metal] are no different, however, from those produced by the shearing of any metal sheet or the like (Rec. pp. 77, 921-2)".

The Court of Appeals found: "... the burrs and sharp edges which it was desirable to remove, *do not lie in the surface planes of expanded metal*,* but between those planes and *within the diamonds* which constitute the mesh work" (Rec. p. 2991).

The president of respondent's predecessor wrote: "I have caused investigation to be made of using wire brushes to whip the material under high speed and endeavor to round those edges. That did not work for various reasons, *principally due to the peculiarity of the material itself and the shape of the mesh*" (Rec. p. 1973).

II.

Respondent's statement (Br. p. 2): "Actually, the brushes are applied in the only conceivable way of ap-

*Emphasis in quotations ours throughout Appendix.

plying them, that is, by bringing them to bear against the meshwork sheets with sufficient pressure to accomplish the desired result". Respondent cites no authority for this statement.

Petitioner's expert Sessions, under cross-examination by respondent's counsel, testified:

"Q. And from the standpoint of the action upon metal the brushes with which you are familiar as having been used in the art acted the same as the brushes used in the patent in suit?

"A. No, I think not. There is an action here in the brushing of these diamonds which calls upon the sides of the brushes away from the point, sides of the bristles away from the point to engage the sides of the diamonds and wipe or slice those edges of the diamonds which would not be touched by the ends of the bristles, such as in the brushing of a flat plate with a perfectly plain surface, there would be no difficulty in all of the ends of the bristles striking the plate.

"Q. Yes, but that is by virtue of the fact, is it not, Mr. Sessions, that we happen to have a particular type of material here that happens to have a particular form of opening in it? The action of the brush, however, in the case of the old uses to which you have referred and the new uses here which is alleged to be new, in so far as contact and removal of metal is concerned, broadly speaking, would be the same?

"A. No; no, I don't agree with you there, Mr. Olson. *These bristles, the sides of the bristles back of the point have a function in deburring this diamond machine [mesh], a function which they do not have in brushing any other materials with which I have been familiar*" (Rec. pp. 92-3).

III.

Respondent's statement (Br. p. 3): "Its [petitioner's] expert also admitted that the Cross patent lies in the old scratch brushing art" (Rec. p. 107).

Nothing could be farther from the truth. Petitioner's expert testified that machines for brushing imperforate metal sheets which he had been discussing earlier in his testimony were in the old scratch brushing art. His exact testimony, referring to his earlier testimony, was, "*The art which was under discussion was the old art of scratch brushing the surface of sheet metal*" (Rec. p. 107).

IV.

Respondent's statement (Br. p. 3): "The suitability of wire brushes for treating material having irregular surfaces is a matter of common knowledge", referring to Broderick patent 869,478 (Rec. p. 2445).

Not only is this statement anything but complimentary to the Buckman patents, "concededly the most pertinent references" (Rec. p. 2992), but it is belied by the Broderick patent itself. See Figure 2 (Rec. p. 2442), from which it is manifest that only flat sheets can be treated (they must lie between the brush 24 and the conveyor 17). The portion of the specification of Broderick quoted at the bottom of page 3 of respondent's brief manifestly refers only to minute irregularities in the flat sheets. Moreover, *scouring* or *burnishing* of flat sheets is a far cry from removal of burrs and sharp edges from expanded metal.

V.

Respondent's statement (Br. p. 4): "Contrary to petitioner's contentions, the [American Brass Co.] machines were adjusted and operated for these tests in a

perfectly normal manner", referring to what respondent calls "*inter partes* tests" (Br. p. 4), which were in fact tests conducted *solely* under respondent's supervision according to respondent's carefully prepared directions (Rec. pp. 847, 917).

The fact is that both the Buffalo machine and the Ansonia machine of American Brass Co. were operated during the tests in most unorthodox fashion. The leveling rollers, which were for the purpose of loosening scale on copper slabs, were retracted prior to the tests "so that there was nothing to guide the material [expanded metal] in and hold it at its proper rate of travel; after it hit this brush it jumped forward, so that that portion of the metal was not brushed by this brush" (Rec. p. 1867).

Also, the backing up rollers for the brushes "were very bright indeed" on the day of the test at Buffalo, "whereas when I had examined them in Buffalo on March 8th, they were dull and dirty, indicating they had not been in contact with the brushes. And I also noticed that there were a growing number of digs, scratches and deep digs in the surfaces of these rolls" (Rec. pp. 1867-8).

In the American Brass Co. machines the "backing up roll under the brushes is in such a position that it destroys the efficiency of the brush" (Rec. p. 1929).

Other evidence as to abnormal operation of the American Brass Co. machines during the tests run by respondent appears at pages 1864-75 and 1927-30 of the record. Even the designer of the machine testified at Ansonia, when questioned as to why the unusual procedure of the tests was followed, "I do not know; I was directed to do so" (Rec. p. 937).

VI

Respondent's contention at the middle of page 4 of its brief that burrs and sharp edges on sheared metal sheets passed through the American Brass Co. machines in normal use "were satisfactorily removed by the brushes" is refuted by an eye witness who observed that the shear fin was "still present after the pieces had gone through the brushing machine" although bent "More nearly into the plane of the slab" by the levelling rolls (Rec. p. 1865), which were retracted and rendered inoperative when respondent ran its tests on expanded metal*.

Thus it is evident that the American Brass Co. machines taught nothing pointing the way to the Cross invention; quite the contrary, the Cross invention was used as the basis for respondent's "tests" wherein expanded metal was for the first and only time run through those machines (Rec. pp. 834, 938).

VII.

Respondent's statement (Br. p. 6): "Any significance to the allegations that the brushed product eliminated serious conditions of injury to workmen, etc., is negatived by the fact that there is no substantial evidence of such conditions ever existing".

The record:

(A) As to the existence of the problem:

The Master's report states:

"The evidence is convincing, in fact, there is no dispute, but that for some time before Cross perfected his brushing machine, *there had been much objection in the expanded metal industry to the*

* *Supra*, p. 18.

sharp edges and burrs resulting from the processes of making such expanded metal, which is sheared from plain metal sheets." (Rec. p. 2850)

Witnesses of both parties testified to the defects of the old material. The first quotation is from the testimony of defendant's employee Hoffman; the other witnesses were all unbiased users:

"Well, there is no denying that sharp edges have *always* been present on expanded metal or any cut or sheared piece of sheet metal, and naturally that was present on expanded metal to a more or less degree, and *I have known it always*. Some of it is real sharp, and some of it is not. I do know that by care in setting up the knives when they are first sharpened, there is a very small fin edge, *sharp*, on expanded metal; when the knives get dull or when care is not used in the set up, the fin is larger and more pronounced." (Rec. p. 588)

"We had the same trouble as I think every one else had with expanded metal, of fins or wire edge on the expanded metal, which would cause lacerations, objected to very strongly by people that we would want to make guards for. It was used as a strong argument by the woven wire people, saying 'Use woven wire so as not to have that rough edge.' * * * It [the sharp edges] was a point of criticism always." (Rec. pp. 588-9)

"[Workmen would] come in with their hands cut,—especially when they'd stick their hands in between the expanded metal. * * * After a while, I got hooks made for the men to carry it by—hooks about two foot long and hooped on top." (Rec. p. 441)

"* * * hellish stuff to handle. The men were continually cutting their fingers and hands on it. * * * Proctor * * * cut his finger on this expanded

metal. * * * He did not come in for first aid treatment, and he stayed home for a day or two, and this cut that he had got developed blood poisoning and he went to the hospital and died in a few days." (Rec. pp. 410-1)

"* * * we had considerable trouble with the men being cut in handling that expanded metal, and it got so bad at one time that our safety engineer instructed us to compel the men to wear gloves * * *. We had one fatal accident that was traced to the expanded metal." (Rec. p. 421)

"* * * expanded steel would be basically ideal for our purposes, but we found that the first expanded metal we purchased involved danger to the workmen in handling the metal because of the sharp fins on the strands, or the perimeters, or whatever you call them, and necessitated their using gloves, but that in itself was not a cure for it, and while we were very anxious to have this class of metal available in preference to the material we had formerly purchased — that is, woven wire — we subsequently found that we could not use it generally, and its use caused us trouble and for that reason we were virtually forced to forget about the material in its application to our products." (Rec. p. 432)

"* * * we used it [the old expanded metal] for fabricating and it went on for a little while and then the men complained about cutting their hands in handling the mesh * * * and finally got to the point where they absolutely refused, * * * we discontinued using it in our shop." (Rec. p. 249)

Respondent's predecessor advised Underwriters' Laboratories "*that it is impossible to entirely eliminate these small burrs and sharp edges*" (Rec. p. 1963) and

"It is impossible, however, to make any expanded metal that will not have something of a sharp edge". (Rec. p. 1964). The Underwriters' Laboratories reported, *"Sharp edges and burrs were found on all the labelled product."* (Rec. p. 1968)

The Master's report states:

"That for many years there had been an insistent demand for such metal without the sharp edges is very clear from the evidence." (Rec. p. 2850) *"The evidence shows that long before the Cross application date there had been an insistent demand for expanded metal which was free from burrs and sharp edges."* (Rec. p. 2882)

"And in fact this record is replete with evidence introduced in behalf of both parties which is convincing that long before Cross many others had considered such smooth edged fabric as a desirable product, and had made various efforts to make it." (Rec. p. 2844)

(B) As to the solution:

" * * we eliminate those hazards to the workmen * * * deburred expanded metal may be easily handled, readily handled, without the hazardous or dangerous effect."* (Rec. p. 186)

" * * the removal of the sharp fins on the strands has opened up the field anew for us * * * it permits us to compete with the woven wire manufacturers * * *."* (Rec. p. 433)

" * * we are using it ["SAFE-T-MESH"]* for certain definite purposes now, that it would be absolutely impossible to use it in its prior state before the new process."* (Rec. p. 251)

*Petitioner's trade-mark for its deburred expanded metal.

"* * * we can go out to a customer with this material and guarantee him a good smooth finished job, where we could not with the old material." (Rec. p. 416)

"I do get jobs now with the Safe-T-Mesh which I couldn't get before." (Rec. p. 445)

"* * * that ["SAFE-T-MESH"] was, well, as near smooth as you could want anything; and tickled to death we were when we first got that." (Rec. p. 441)

The District Judge held: "The Cross patent was the solution and the response to that objection and demand." (Rec. p. 2927)

VIII.

Respondent's statement (Br. p. 6): "Its [petitioner's] vice-president testified that petitioner never had any complaints that the unbrushed material did not come up to the claims of its literature alleging a high degree of smoothness of that material."

The record: "Q. Did you ever have any complaints from your customers about sharp edges on the expanded metal?

"A. We had innumerable complaints. I have had many of them tell me, 'Can't you do something to eliminate these burrs, these sharp edges, and so forth.'" (Rec. p. 214)

IX.

Respondent's contention (Br. p. 7) that the disclaiming of claim 15 of the Cross patent by petitioner shows "the speciousness of the 'insistent demand' argument" is a *non sequitur*.

Claim 15 was disclaimed because the Master found that it "should be held to be invalid because the evidence shows that *samples* were regularly *filed* to make them smooth" (Rec. p. 2888). This was a tedious hand operation applicable *only* to *samples* and, even so, did not remove the burrs and sharp edges in the sharp crotches of the diamonds (Rec. p. 1670). The insistent demand existed* and the disclaiming of claim 15 is certainly no admission to the contrary.

**Supra*, pp. 19-22.

